Petition

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No.

In the

Supreme Court of the United States

OCTOBER TERM, 1981

McGRAW-EDISON COMPANY,

Petitioner,

vs.

CHARLES L. SIKES, ET AL.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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QUESTION PRESENTED

Whether a state's common law of trade secrets having the effect of abrogating contracts setting terms and conditions for the submission of unpatented ideas and products conflicts with federal policy seeking (a) to promote the incentive to invent and disclose; and (b) to assure that ideas in the public domain remain there for the free use of the public.

Pursuant to Rule 28.1 of this Court, Petitioner McGraw-Edison Company states that it has no parent companies and that it has the following affiliates (other than wholly owned subsidiaries): Onan Corporation (Delaware), Electric Machinery Industrial Controls Corporation (Delaware), Colombiana De Frenos, S.A. (Colombia), Farloc Argentina S.A.I.C.Y.F. (Argentina), Frenos Hidraulicos Automotrices S.A. (Mexico), Niigata Masoneilan Co., Ltd. (Japan), Projectores Cibre Do Brasil, S.A. (Mexico), Worthington De Mexico S.A. (Mexico), and Worthington Nord S.p.A. (Italy).

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Petitioner, McGraw-Edison Company, respectfully prays that a writ of certiorari issue to review the judgment entered on January 14, 1982, rehearing denied on March 25, 1982, by the United States Court of Appeals for the Fifth Circuit.

OPINIONS BELOW

The opinion of the Court of Appeals for the Fifth Circuit is reported at 665 F.2d 731 and is reproduced in the Appendix hereto. The opinion of the Court of Appeals for the Fifth Circuit denying rehearing is not yet reported. It is reproduced in the Appendix hereto.

JURISDICTION

The judgment of the Court of Appeals for the Fifth Circuit was entered on January 14, 1982. A timely petition for rehearing was denied on March 25, 1982. The jurisdiction of this Court arises under 28 U.S.C. §1254(1).

STATEMENT OF THE CASE

This action for alleged breach of contract and of a confidential relationship was filed in the Texas State Court in Midland, Texas, and removed to the United States District Court. Federal jurisdiction is based on diversity of citizenship.

Charles L. Sikes conceived of a lawn trimmer and submitted his concept to McGraw-Edison Company after the parties had signed a letter agreement (PX1, A20a) that provided that McGraw-Edison would keep the information confidential and not use it for its own benefit without Sikes' prior written consent or under some conditions set forth in the letter. Among the conditions stated were:

> "This confidential disclosure agreement shall remain in full force and effect between myself and McGraw-Edison Company for a period of two (2) years from date of disclosure, unless such submitted information can be shown by McGraw-Edison Company to have been in its possession, or of public knowledge, or to have been in the public domain prior to such submission • • • •".

Sikes disclosed his idea to McGraw-Edison both by written material and by exhibiting an actual device. The device was a Black & Decker Model 8200 grass trimmer which had been modified by Sikes to incorporate a replaceable flexible non-metallic line as the cutting element.

The Black & Decker Model 8200 was an inexpensive lightweight grass trimmer with a short metal blade which could be operated with one hand and trim small areas. Sikes removed the steel cutter blade and shroud which were on the original trimmer, drilled a hole diametrically through the end of the shaft, and inserted a monofilament line with one end enlarged. (Tr. 68-77)

Included in the written material submitted by Sikes was a written description of then commercially available grass trimmers using flexible non-metallic lines. These had line storage spools on the shafts, were relatively heavy with large motors, requiring two handed operation, and were expensive (PX 14, pp. 1-3, A22a-23a). The advantages of the modified Black & Decker Model 8200 were said to be: a small weight motor which permitted using the device with only one hand and which would load down when the line came in contact with a tree or housing reducing line breakage as compared to the larger motors then used on line grass trimmers; easy replacement of worn lines; a shorter line which facilitated trimming small areas; and a much less expensive trimmer (PX 14, pp. 3-4, A23a). The disclosure included a "Summary" reading (PX 14, pp. 4-5, A23a):

> "The heart of the invention presented here is a light weight shaft with a specially designed hole through the shaft in such a manner as to facilitate a specially designed flexible non-metallic cutting line. A properly selected motor is used to rotate the shaft and the line, for the purpose of cutting vegetation. The cutting line, with one end enlarged is held in the rotating shaft by centrifugal force, thus allowing for the quick and easy replacement of the cutting line when it becomes worn."

Some months before Sikes submitted his idea, Stephen E. Schubert, then living in North Little Rock, Arkansas, had disclosed a grass trimmer to McGraw-Edison. He explained that he had made his device "by slightly modifying a Black and Decker Model 8200 grass trimmer" (DX D, A32a-35a). The modifications were to (1) remove the steel cutter blade, (2) remove the cutter blade shroud, (3) drill a hole diametrically through "the plastic blade holder" on the end of the shaft (this is at the same place which Sikes drilled his hole), and (4) thread a single piece of flexible plastic line with a knot or bulb on one end through the hole (DX D, A33a). Schubert explained that the device is "light, easily maneuverable, safe to operate and low in cost" (DX D, A33a).

A consulting engineer, Brune, called as a witness by Sikes, testified that the "basic concept" of Schubert and Sikes was "exactly the same". (Tr. 288, A38a)

The ideas of Sikes and Schubert were not kept secret. They were disclosed to relatives and other f ends and used in public. In addition to his relatives, Sikes told about a dozen people at the laboratory where he worked and he estimated that before he disclosed the idea to McGraw-Edison there were "well over 20 units being used by lab personnel." (PX 7, A24a). Schubert made devices for relatives and demonstrated his device to others—on one occasion to a gathering of 20 people. (Tr. 506-7, A40a)

The "Graswip" grass trimmer which McGraw-Edison marketed subsequent to Sikes' disclosure to it employs a single line. The line has an eyelet or connector on one end which slips over a post on the hub at the end of the shaft. There is a rim extending around a portion of the

circumference of the shaft and the line passes outward through a hole in the rim.

McGraw-Edison sought and obtained a patent covering the means by which it secures the line to the end of the shaft. (Tr. 489) The patent, No. 4,118,865 (DX AA, A25a), contains limitations as to the hub, connector, post and rim not present in the Sikes disclosure. Sikes sought patent protection for his idea (DX A, A43a-51a). No patent was allowed. Had any of the claims Sikes sought been allowed, they would not have found response in the McGraw-Edison trimmer because they were limited to Sikes' hole extending "entirely" through the shaft or holder with an enlarged end of the line in contact with the holder.

The case was tried before a jury which found for the plaintiffs with damages set at $900,000. Judgment was entered for this amount and affirmed by the Court of Appeals.

The trial judge instructed the jury as to "trade secret" law saying in part:

> "You are instructed that a trade secret may be a device or process which is patentable, but it need not be that. It may be a device or process which is clearly anticipated in the prior art or one which is merely a mechanical improvement that a good mechanic can make."

REASONS FOR GRANTING THE WRIT

1. The Position Of The Fifth Circuit In The Present Case Conflicts With Both The Holdings Of This Court And Federal Patent Policies.

By upholding a judgment for the submitter of a new product idea, recovery being granted *not* under the contract by which the idea was submitted but under Texas "trade secret" law, the Fifth Circuit essentially abrogated the provisions of the agreement under which the recipient agreed to consider the new product idea.* This refusal to uphold the contractual provisions between the parties runs directly counter to the principle that inventors should be able to enter into binding contracts regarding their inventions, as held by this Court in *Aronson* v. *Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979):

> "Permitting inventors to make enforceable agreements licensing the use of their inventions in return for royalties provides an additional incentive to invention."

In *Aronson*, this Court pointed out that enforcement of agreements for submitted ideas was "even less offensive to federal patent policies than state law protecting trade secrets," 440 U.S. at 266. The reason for this is that once an unpatented submitted idea is commercialized, any member of the public may copy it, and hence there

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* The agreement provided that McGraw-Edison had no obligation with respect to information that was "in its possession, or of public knowledge or to have been in the public domain prior to such submission." (A20a) All three conditions existed.

is full public disclosure, as in this case. On the other hand, the very purpose of trade secret law is to prevent such public disclosure. (See 440 U.S. at 266)

In refusing to honor the contractual provisions in this submitted idea case, the Fifth Circuit has further advanced the likelihood that companies will refuse to consider submitted ideas. Since, pursuant to the decision of the Fifth Circuit, reliance cannot be placed upon a contract under which an idea is submitted and received, the recipient must either accept the idea at his peril or refuse to deal at all with the inventor. The inevitable result is to hamper the bringing of inventions into the public domain and impede the disclosure of technology to the public.

Not only does this hamper the bringing of inventions into the public domain, it ultimately reduces the incentive to invent, since it decreases the potential sources to which an inventor may look for commercialization of his inventions. This is contrary to the purposes of the federal patent system, as expressed in *Aronson*, 440 U.S. at 262:

> "First, patent law seeks to foster and reward invention; second, it promotes disclosure of inventions to stimulate further innovation and to permit the public to practice the invention once the patent expires; third, the stringent requirements for patent protection seek to assure that ideas in the public domain remain there for the free use of the public."

In an era when our country is falling behind in technological innovation, any impediment to the creation and public utilization of new products and ideas is of national concern.

In *Lear, Inc.* v. *Adkins,* 395 U.S. 653, 675 (1969), this Court emphasized the importance of the issue, but declined to decide the extent to which states could regulate unpatented ideas under state contract law:

> "Consequently, we have concluded, after much consideration, that even though an important question of federal law underlies this phase of the controversy, we should not now attempt to define in even a limited way the extent, if any, to which the States may properly act to enforce the contractual rights of inventors of unpatented secret ideas. Given the difficulty and importance of this task, it should be undertaken only after the state courts have, after fully focused inquiry, determined the extent to which they will respect the contractual rights of such inventors in the future . . . ."

While the *Aronson* case resolved the general principle of the enforceability of such contractual rights, and decided one particular aspect of the unresolved issue of *Lear,* the Fifth Circuit has now circumvented the general principle of enforceability found in *Aronson* by using Texas trade secret law to negate the protective provisions under which the recipient agreed to consider the submitted new product idea. The contract in this case was utilized to establish a confidential relationship between the parties, but the remainder of the contract was then discarded in awarding recovery under trade secret law. Just as there was no justification in *Aronson* to relieve "Quick Point of its contract obligations," so there is no reason here to relieve Sikes of his contract obligations, especially when his rights are based on that contract.

In both the *Lear* and *Aronson* cases, the emphasis was on the contractual rights of inventors. However, it is clear that if the contractual rights of inventors are to be

protected, the contractual rights of recipients must also be protected.

Although referring to trade secret licensing rather than the submission of new product ideas, the reasoning of this Court in *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470 (1974) as to the problems arising if trade secrets could not be licensed is directly applicable. The relevancy is immediately apparent if this reasoning is read from the standpoint of what would occur if a recipient of a submitted idea is precluded from relying on his contractual rights:

> "The holder of a trade secret would not likely share his secret with a manufacturer who cannot be placed under a binding legal obligation to pay a license fee or to protect the secret. The result would be to hoard rather than disseminate knowledge, Painton & Co. v. Bourns, Inc., 442 F.2d, at 223. Instead, then, of licensing others to use his invention and making the most efficient use of existing manufacturing and marketing structures within the industry, the trade secret holder would tend either to limit his utilization of the invention, thereby depriving the public of the maximum benefit of its use, or engage in the time-consuming and economically wasteful enterprise of constructing duplicative manufacturing and marketing mechanisms for the exploitation of the invention. The detrimental misallocation of resources and economic waste that would thus take place if trade secret protection were abolished with respect to employees or licensees cannot be justified by reference to any policy that the federal patent law seeks to advance." (pp. 486-487)

Under the Fifth Circuit approach, these results would occur not by fear on the part of the inventor, but by the refusal of manufacturers to consider the idea as a result of their fears.

Although *Kewanee* established that there is no blanket pre-emption of state trade secret law by federal law, the use of state trade secret law in this case to abrogate a contract in violation of the general principle of *Aronson*, and thus threaten the goals of federal patent policy, raises the question of the extent to which trade secret law may be stretched without coming into conflict with federal patent policy. The use of trade secret law to abrogate the terms of a written contract governing the submission of a new product idea is inconsistent with the *Aronson* case and unduly extends the holding of *Kewanee*, creating a conflict between those cases where none should exist. This improper extension of state trade secret law to abrogate the type of agreement found to be desirable in *Aronson* runs counter to the federal policy of promoting innovation and disclosure of new ideas.

The very serious nature of the failure of the United States to maintain its long-time leadership in "promot[ing] the Progress of Science and useful Arts," contemplated by the Founding Fathers (Article I, § 8, U.S. Constitution), is exemplified by the comments and materials entered into the Congressional Record* by Senator Birch Bayh in connection with the "University and Small Business Patent Procedures Act." Thus, "America is falling behind its international competition in technological innovation" (S504) and "The problems of lagging innovation and productivity have now become so obvious. . ." (S3121). In an article in the November 16, 1978 Washington Post, entitled "Waning of Innovation is Seen," we find:

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* Congressional Record: January 23, 1979, S503-S504; February 9, 1979, S1440-S1449; March 21, 1979, S3121-S3122; May 22, 1979, S6460-S6461; and September 26, 1979, S13511.

> "'These indicators are distressing,' said Elmer B. Staats, U.S. comptroller general. Stressing the historical importance of technological innovation in powering America's economic growth, Staats warned that unless specific steps are taken to stimulate innovation, Americans can expect their standard of living to stagnate and their competitive ranking in the world to weaken." (S1447)

Much of the innovative energy in the United States is generated by individual inventors and small businesses.* While some of these inventors are capable of developing and marketing their new products, most must turn to established companies in the field. However, many companies already refuse to accept submitted ideas in view of the potential litigation and possible liability, Milgrim, "Trade Secrets," § 8.03(2), p. 8-42.** The only possible recourse for the potential recipient of a submitted idea, who has an interest in considering possible commercialization of the product, is to enter into an agreement containing provisions that protect the recipient if the submitter does not provide information that the recipient does not already have available, such as the provisions in the agreement entered into by the parties in this case.

While the Fifth Circuit decision abrogating this express contract between the parties favored the submitter of the idea in this case, in the next case it could favor

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* See, e.g., the comments and materials entered into the Congressional Record by Senator Weicker in introducing the "Small Business Innovation Act of 1979," October 4, 1979, S14082, et. seq.; "Licensing Law and Business Report," Vol. 3, No. 8, March, 1981.

** See also, "Licensing Law and Business Report," Vol. 3, No. 8, March, 1981.

the recipient. Neither result can justify a decision that jeopardizes the federal patent policy of fostering innovation and disclosure. As stated in an editorial of Science Magazine, dated June 30, 1978 (Congressional Record, February 9, 1979, S1444): "It begins to appear that we have thought of 'science policy' too much in terms of stimulating R & D and too little in terms of liberating its results." Disclosure and use of new product ideas, as well as the incentive to create them, should be released from the bondage created by this Fifth Circuit decision in derogation of federal policy.

2. The Decision Of The Court Of Appeals Is In Conflict With Decisions Of Other Courts Of Appeal As To The Requirement Of Novelty In A Submitted New Product Idea.

Not requiring novelty of a submitted new product idea is contrary to the federal patent policy "that ideas in the public domain remain there for the free use of the public." *Aronson* v. *Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979).

While the submission of an idea in confidence has some similarity to a confidential disclosure of a trade secret as defined in the Restatement, Torts No. 757, other courts have recognized a distinct difference on the question of the novelty required. For example, in *Wilkin* v. *Sunbeam Corp.*, 377 F.2d 344 (10 Cir. 1967), an idea for an automatic electric grill was involved. The Court explained that the defendant was charged with having used "secret information, in the nature of a trade secret, given in confidence." The Court recognized, however, that it was not dealing with a trade secret in the Restatement sense, but rather with the submission of an idea. It said, in part (377 F.2d 346):

> "On the issue of liability for alleged appropriation of another's idea, the essential elements which a claimant is required to establish as a prerequisite to a right to relief are: '(1) that the idea disclosed must be novel. . . .'"

Among the decisions by other courts, holding that there is a requirement of novelty in the submission of an idea, are:

De Filippis v. *Chrysler Corp.*, 53 F.Supp. 977, 980 (S.D. N.Y. 1944); aff'd. 159 F.2d 478

Canfield v. *Blaw-Knox Company*, 98 F.2d 805, 807 (3 Cir. 1938)

Richter v. *Westab, Inc.*, 529 F.2d 896, 900-901 (6 Cir. 1976)

Mitchell Novelty Company v. *United Manufacturing Company*, 199 F.2d 462, 465 (7 Cir. 1952)

Wilkin v. *Sunbeam Corporation*, 377 F.2d 344, 346 (10 Cir. 1967)

The jury was instructed as to trade secret law in accordance with the Restatement, Torts No. 757. This is sound law as applied by all courts to the strict "trade secret," defined in the Restatement as:

> ". . . any formula, pattern, device or compilation of information which is used in one's business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it."

Such a "secret" may, indeed, be something which is known and old — if the fact of use of it by the proprietor is not known to others. However, this law has no application to the situation in which one submits an idea, such as an idea for a new product to another.

In the instant case, advising the jury that the device may be one "which is clearly anticipated in the prior art or one which is merely a mechanical improvement that a

good mechanic can make," is clearly in conflict with the decisions of other courts. It is particularly bad when, by the contract, McGraw-Edison was free to use what was "in its possession, or of public knowledge, or to have been in the public domain prior to such submission."

Here, Schubert and Sikes, himself, had made the idea of public knowledge and in the public domain prior to the disclosure to McGraw-Edison. Schubert made units for his son and for a son-in-law. (Tr. 507) His neighbors saw his unit and, on one occasion, he demonstrated it to a group of 20 people. (Tr. 506-507, A40a) Sikes likewise showed it to others and before disclosing it to McGraw-Edison, wrote (PX 7, A24a):

> "Presently there are around 200 people in the development lab building where I work. During the summer I have told about a dozen people about my invention. Presently it is conservatively estimated that there are well over 20 units being used by lab personnel."

It is to be recalled that in determining what is public knowledge and use which places a device in the public domain, "The prior knowledge and use by a single person is sufficient." (*Coffin* v. *Ogden*, 85 U.S. 120, 124 [1873]) Here there was public knowledge by many.

In *Egbert* v. *Lippmann*, 104 U.S. 333 (1881), the inventor of a novel corset stay gave a corset to a friend who wore it for several years. Even though the stays were concealed within the corset and the corset concealed by other clothing, there was public knowledge and use and the stay was in the public domain. In the case of Sikes and Schubert, there was clear public knowledge and use with members of the public owning devices, knowing their structure and exhibting them to others.

CONCLUSION

The Fifth Circuit decision creates conflicts between state trade secret law and the holdings of this Court, between state trade secret law and the federal patent policies, and between the Fifth Circuit and other Circuit Courts of Appeal. A writ of certiorari should issue to review the judgment entered by the Court of Appeals for the Fifth Circuit and resolve the conflicts that it has raised.

Respectfully submitted,

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Appendix

APPENDIX

Charles L. SIKES and Arnold T. Sikes,
Plaintiff-Appellees Cross-Appellants,

v.

McGRAW-EDISON COMPANY,
Defendant-Appellant Cross-Appellee.

No. 80-2089.

United States Court of Appeals,
Fifth Circuit.

Jan. 14, 1982.

Developer of lawn trimmer brought action against manufacturer alleging wrongful appropriation of his trade secret and violation of nondisclosure agreement between the parties. The United States District Court for the Western District of Texas, Lucius Desha Bunton, III, J., entered judgment on jury verdict for plaintiff, and defendant appealed. The Court of Appeals, Gee, Circuit Judge, held that: (1) definition of trade secret under Texas law was not improperly given to jury; (2) evidence sustained jury's findings that defendant used plaintiff's device and that defendant violated its nondisclosure agreement with plaintiff; (3) court's charge on damages instrucing jury to compensate plaintiff for actual damages and amount by which defendant was unjustly enriched was proper; and (4) $900,000 award was not excessive.

Affirmed.

1. Torts — 28

In action in which developer of lawn trimmer alleged that manufacturer had wrongfully appropriated his device in marketing a similar product, trial court properly gave trade secrets definition under Texas law as the device was not a "new product idea."

2. Torts — 27

In action in which developer of lawn trimmer alleged that manufacturer had wrongfully appropriated his device in marketing a similar product, evidence supported jury verdict that manufacturer used plaintiff's device in developing its product.

3. Torts — 27

In action in which developer of lawn trimmer alleged that manufacturer had wrongfully appropriated his device in marketing a similar product, evidence was sufficient for jury to have found that plaintiff's device was a trade secret protected by Texas law and that defendant breached its nondisclosure agreement with plaintiff.

4. Federal Courts — 908

Torts — 28

In action in which developer of lawn trimmer alleged that manufacturer had wrongfully appropriated his device in marketing a similar product, court's charge on damages which instructed jury to compensate plaintiff for his actual damages and amount by which defendant was unjustly enriched did not authorize a double recovery and was not improperly prejudicial to defendant.

5. Torts — 28

Court's references to infringement and to unjust enrichment was not inappropriate in action for wrongful appropriation of a trade secret.

6. Torts — 28

In action in which developer of lawn trimmer alleged that manufacturer had wrongfully appropriated his device in marketing a similar product, charge on damages instructing jury to compensate plaintiff for actual damages and amount by which defendant was unjustly enriched did not permit jury to appropriate to plaintiff all of defendant's profits from its device rather than merely those attributable to use of plaintiff's device.

7. Torts — 28

In action in which developer of lawn trimmer alleged that manufacturer violated trade secret nondisclosure agreement between the parties, damage charge instructing jury to compensate plaintiff for actual damages and amount of money by which defendant was unjustly enriched did not improperly fail to refer to the contract's two-year limitation on disclosure of the trade secret where defendant did not comply with two-year clause it sought to press into service but, rather, breached it, and where it was uncertain what might have happened had defendant complied with the clause.

8. Damages — 137

Damage award of $900,000 for manufacturer's wrongful appropriation of plaintiff's trade secrets regarding a lawn trimmer was not excessive.

Haight, Hofeldt, Davis & Jambor, Edward A. Haight, Chicago, Ill., Cotton, Bledsoe, Tighe & Dawson, Charles Tighe, Midland, Tex., for McGraw-Edison Co.

W. B. Browder, Jr., Midland, Tex., for Charles and Arnold Sikes.

Appeals from the United States District Court for the Western District of Texas.

Before GEE and RUBIN, Circuit Judges, and SPEARS*, District Judge.

GEE, Circuit Judge:

This diversity case presents issues controlled by the Texas law of trade secrets. Plaintiff-Appellee Charles L. Sikes (Sikes) recovered a substantial judgment below against Defendant-Appellant McGraw-Edison Company (McGraw-Edison), which appeals asserting errors in the

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* District Judge of the Western District of Texas, sitting by designation

court's instructions to the jury, in evidentiary rulings, and excessiveness of damages. Mr. Sikes has lodged a cross-appeal which, however, he states in brief that he wishes to waive in the event the judgment below is affirmed. Since we do affirm, it is waived unless the Supreme Court decides otherwise.

In late 1974, Charles L. Sikes, an electrical engineer and a "tinkerer," was inspired by observation of the powerful "Weed Eater" mowing tool then being successfully marketed to experiment with developing a lightweight trimmer, usable in tight places where bulkier equipment would not fit. Working with a small trimmer already on the market, he modified it by replacing its metal blade with a nylon monofilament line, inserted in a hole drilled at the end of the power transmission wand and held in place by an enlarged end and the operation of centrifugal force.

In early 1976, Mr. Sikes demonstrated his device successfully to McGraw-Edison and provided it with written material and engineering drawings. Before he did so, the parties entered into a letter agreement providing, in pertinent part:

> This confidential disclosure agreement shall remain in full force and effect between myself and McGraw-Edison Company for a period of two (2) years from date of disclosure, unless such submitted information can be shown by McGraw-Edison Company to have been in its possession, or of public knowledge, or to have been in the public domain prior to such submission . . . .

At this demonstration, which commenced indoors and later proceeded to the plant yard, the McGraw-Edison employees seemed highly enthusiastic about Mr. Sikes' device.[1] As the demonstration progressed, more and more

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[1] Here and throughout our opinion, we view the evidence in the light most favorable to the jury verdict, as settled law requires.

highly placed executives were summoned to watch. Their comments suggested to Mr. Sikes that they had never seen quite such a device before; none gave any indication that any similar one was known to them. Sikes was twice asked how much he wanted for the invention. His response of $50,000.00 cash and a 50 cents per unit royalty produced the rejoinder that the cash asked was a little too high but the royalty seemed about right. Matters concluded with Mr. Sikes' leaving his model and papers with McGraw-Edison for their further study.

About two weeks later, McGraw-Edison invited Mr. Sikes to return to Missouri, where the first demonstration had been held, for further negotiations. He went, accompanied by his brother. At this session, the McGraw-Edison personnel took a somewhat different line.

Though at the earlier conference they had indicated keen interest and had confided both that a somewhat comparable device which they had under development would not be ready for two years and that it was vital that they bring a trimmer out in time for the August 1976 home product show, at this time they advised the Sikes that their own product was already developed. He was told that even so they maintained an interest in his device because their's would cost a few cents more to manufacture. Sikes rejected the offer of this amount — "about 8 cents" — per unit as a royalty. Negotiations faltered and, later, came to a close.

McGraw-Edison met the August deadline with its "Graswhip," a device remarkably similar to that of Mr. Sikes and one which has proved a considerable success. This suit followed in due course, asserting that McGraw-Edison had improperly availed itself of Mr. Sikes' device in bringing out the Graswhip. The jury awarded $900,000 damages. In several points of error, McGraw-Edison urges that it did not use Mr. Sikes' ideas, that they were already known to it, that they were already public knowledge at the time of their disclosure to McGraw-Edison by Sikes, and that the court's instructions

to the jury on damages and on the Texas law relating to trade secrets were wrong. It is convenient to take up the last of these points first.

Texas Trade-Secret Law

McGraw-Edison concedes that the definition of trade secrets given the jury was correct Texas law. We shall have occasion to refer to it later:

> You are instructed that a trade secret may be a device or process which is patentable, but it need not be that. It may be a device or process which is clearly anticipated in the prior art or one which is merely a mechanical improvement that a good mechanic can make. Matters of general knowledge in an industry cannot be taken by one person as a trade secret, nor as a simple and obvious change in an existing device or process entitled to protection as a trade secret. There must be some improvement which gives the one using the device or process an opportunity to obtain an advantage over competitors who do not know of the device or process or uses.

This definition is taken in part from that of the original Restatement,[2] one which has been quoted with approval by the Texas courts. *K & G Oil Tool & Service Co.* v. *G & G Fishing Tool Serv.*, 158 Tex. 594, 314 S.W.2d 782, 789 (1958); *Hyde Corp.* v. *Huffines*, 158 Tex. 566, 314 S.W.2d 763, 776 (1958). There can be little doubt that it represents good Texas law.

[1] McGraw-Edison argues, however, that the definition was improperly given the jury because Mr. Sikes' device was not a trade secret at all, but something different: a "new product idea." In doing so it finds comfort in a single authority, *Richter* v. *Westab, Inc.*, 529 F.2d 896 (6th Cir. 1976), which does indeed draw this distinction. For several reasons, however, we conclude that this reliance on *Westab* is misplaced.

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[2] Restatement, Torts § 757 (1939).

First, the "secret" involved in *Westab* was that a school supply firm could improve sales of notebook covers and binders by employing on them fashion designs and fabrics matching those being currently advertised in young women's fashion magazines. This is a mere abstract idea, a marketing concept, and is so characterized by the *Westab* court. *Westab*, at 900-902. As such, it is a far cry from Mr. Sikes' functioning grass trimmer, and we doubt that principles developed by the *Westab* court to deal with it have application here.

Second, McGraw-Edison argues that here, as in *Westab*, no competitive advantage was provided by the Sikes device because it could be copied as soon as it was marketed. This argument fails for a number of reasons. The first is a factual one: the evidence here is such as amply to support a conclusion by the jury that the Sikes device gave McGraw-Edison an opportunity to steal a march on competitors unfamiliar with it, as indeed McGraw-Edison did. In a nutshell, it shows—viewed most favorably to the verdict — that McGraw-Edison had been struggling to develop such a product, that it believed itself two years away from success at the time of Mr. Sikes' disclosures, that the first working drawings of the Graswhip were dated after that disclosure, that the Graswhip was developed from the Sikes device and put on the market within six to eight months from its disclosure, and that the Graswhip was a success. The second is a legal one: Texas law does not seem much impressed by the circumstance that a device, once marketed, can be readily copied. In *K & G Oil Tool & Service Co., supra,* for example, an award of damages was affirmed against one who disassembled a tool in violation of an agreement not to do so and copied it, even though the jury found that the internal construction of the tool could be sufficiently determined for copying without disassembly. That the offender *could* have obtained the information without violating its agreement did not signify where in fact it *did* obtain it by doing so. By a parity of reasoning, that

a competitor could have copied the Sikes device once it was marketed — which is to say little more than that it was not patented or patentable—does not mean that having it available did not confer at least a temporary competitive advantage on McGraw-Edison.

In sum, we conclude that McGraw-Edison's arguments based on the *Westab* distinction must fail, essentially because the Sikes device is of such a kind as to fall within the Texas concept of trade secret. We next address briefly the contention that McGraw-Edison did not use the Sikes device in developing its Graswhip.

Did McGraw-Edison Use The Sikes Device?

[2] Little need be said in response to this contention, essentially one that record evidence does not support the jury verdict. Pointing to a different mode of attaching the nylon flail to the end of the Graswhip's power wand, McGraw-Edison argues that this is dispositive of the matter. The Sikes device employed a short length of monofilament having a bulb at one end, threaded through a transverse hole across the wand's full diameter and held in place by centrifugal force. The Graswhip's nylon flail replaced the bulb with an eyelet threaded over an axial peg at the end of the wand, with the length of line passing out through a hole in one side of the wand. We are not convinced.

We have briefly summarized above the evidence that, viewed most favorably to the verdict, amply supports it. Much of it came from employees or former employees of McGraw-Edison. To quote the testimony of one witness only, a former McGraw-Edison Vice-President in charge of tool-division marketing:

> Q But, Mr. Sullivan, couldn't you have just taken a Weed Eater and take off the guard or take off its spool for putting a cord in and out and just any man in your shop have come up with this thing in two days?

A I suppose the answer to that is yes, they could have, but the other answer is no, they didn't. They weren't able to. There was no, we had never thought of doing that kind of thing.

Q Had you then been working on that trying to get a lawn trimmer?

A Well, some time in 1975 Mr. Spencer directed that the products policy committee and the engineering department and the manufacturing to cease talking about a nylon line grass trimmer. He didn't want to hear about it any more, for whatever reasons he had. We were unsuccessful, he didn't think we were going to be able to get around the patents that Weed Eater had and he didn't want to hear about it any more . . . . And I think we all got the message, and we were not, we had no time or talents being spent on a nylon line grass trimmer at the time that Mr. Sikes visited our office.

Q . . . I want to ask you, did McGraw-Edison use this [Sikes'] tool for some purpose in its development of its own tool?

A I would say that this tool was the start of McGraw-Edison's development of their Graswhip, that this was the tool that we used out in the field for testing, and we took our motors and our envelopes and tried to develop the tool from this product, from this one here.

Any contention that on such evidence the jury could not properly find that McGraw-Edison used the Sikes device in developing its Graswhip is meritless.

Did McGraw-Edison Violate Its Non-Disclosure Agreement With Mr. Sikes?

A more serious group of contentions by McGraw-Edison concerns whether the express agreement that it had with Mr. Sikes was breached by its actions in appropriating his device. Since the parties entered into such an express agreement governing their relationship resulting

from the disclosure, questions of implied contract do not arise.

Their agreement, as pertinent here, provided that McGraw-Edison would not, for two years after the disclosure by Mr. Sikes, use or disclose the information submitted by him "unless such submitted information can be shown by McGraw-Edison Company to have been in its possession, or of public knowledge, or to have been in the public domain prior to such submission . . . ." The court charged the jury in exact conformity with this language, directing it to find for McGraw-Edison if any of the above circumstances was established by a preponderance of the evidence. Since it did not, the question becomes whether its verdict is clearly erroneous on the basis of the evidence.[3]

It is clear that much of the information transmitted to McGraw-Edison by Mr. Sikes was of a public nature. The basic machine, for example, was a commercial trimmer, available on the open market. Many features of the machine, even as modified, were disclosed by prior patents or otherwise generally known. And McGraw-Edison itself had received disclosure earlier from a Mr. Schubert of a modification of the same commercial trimmer to incorporate a nylon flail, though one of a somewhat different size and considerably greater length than that of the Sikes device — 6 to 9 inches, as opposed to 2.8 on

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[3] Mr. Sikes argues strenuously that on the authority of *K & G Oil Tool & Service Co.*, cited in text, it matters not that McGraw-Edison could have obtained the information elsewhere if in fact it got it from him. This argument overlooks the terms of his express contract, which appear to rule out such questions of causation and, strictly construed, absolve McGraw-Edison from any duty of non-use if it in fact possessed the disclosed information already, or if it was in fact public knowledge, etc. Since we conclude that the jury could properly have found that it was none of these things, we need not decide whether this contention has any place in such a case as this.

the Sikes device and 2.9 on the Graswhip.[4] The Schubert disclosure was one of mere paper plans, however, and no working device was furnished by him. Hence his disclosure could not and did not show, as Sikes' did, that the exact device disclosed would function and function effectively. Sikes, moreover, disclosed to McGraw-Edison that a slightly larger motor would produce better results than did that on his device, and the Graswhip duly incorporated one.

[3] We think that under the concededly correct definition of trade secret under Texas law given the jury by the trial court, this evidence permitted it properly to find that the Sikes device was such an "improvement which gives the one using the device or process an opportunity to obtain an advantage over competitors who do not know of . . ." it as Texas law protects. More to the present point, we think it could also properly have concluded that the Sikes device, actual and functioning, went significantly beyond any "information" in McGraw-Edison's possession, of public knowledge, or in the public domain at the time of its submission. Indeed the evidence indicates and the jury could properly have found that the device was the first successful one of its kind, a lightweight grass-cutting flail that did not infringe the Weed Eater patents.[5]

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[4] There was expert testimony that these differences, though to laymen such as we they do not seem large, were significant because of the sensitivity of small motors to loads imposed.

[5] This is not to say that were we presented with the issue we would make such an initial finding, only that the jury could properly have done so. Nor is it to say that merely presenting a working model of what another already has on paper, without significant change, entitles one to protection; here there was evidence that Sikes' changes were significant improvements over anything then known.

In these circumstances, we find our case analogous to *Water Services, Inc.* v. *Tesco Chemicals*, 410 F.2d 163, 173 (5th Cir. 1969), where, speaking of the first successful, fully automated system for purifying water for industrial use, we said:

> The district court found that the components were not developed by Farris, were available on the open market, and were ascertainable. It is clear that the *theory* of the Treat-A-Matic was not new to the industry. The court also found that the design was apparent from inspection, and that the system had been sold and advertised without restriction. These findings are supported by the evidence. But these findings are not conclusive. The trade secret here was the application of known techniques and the assembly of available components to create the first successful system in the industry. In the trial judge's words, "no components had been brought together into one lightweight automated system until the perfection of the Treat-A-Matic." As the Second Circuit stated in *Imperial Chemicals, Ltd.* v. *National Distillers & Chemical Corp.*, 2 Cir. 1965, 342 F.2d 737, 742, "a trade secret can exist in a combination of characteristics and components, each of which, by itself, is in the public domain, but the unified process, design and operation of which in unique combination, affords a competitive advantage and is a protectible secret." This characterization describes the TREAT-A-MATIC. The composition was unique and conferred a substantial competitive advantage on Farris. Indeed, the company enjoyed unparalleled financial success during the four years that competitors were unsuccessfully trying to duplicate the TREAT-A-MATIC."

Tesco, to be sure, concerns Georgia law. But Georgia, like Texas, recognizes the Restatement definition of trade secret; and we think our language there apposite here. The jury could properly have found, as it did, that Mc-

Amount of Damages and the Damages Instruction

[4] The court's charge on damages instructed the jury to compensate Mr. Sikes in that amount shown by a preponderance of the evidence to represent his "actual damages, if any, caused by the Defendant's infringement and the amount of money by which the Defendant was unjustly enriched, if any, as a consequence of Defendant's infringement." McGraw-Edison objects to the charge on several distinct grounds and contends as well that the $900,000 award is "monstrous" and excessive.

First, it complains that the charge authorizes a double recovery: "both the damages to Sikes and the McGraw-Edison profits." The contention is not wholly without merit, for the charge—to the eye of a lawyer—is perhaps technically subject to such a construction. For reasons which we note below in our discussion of the amount awarded, however, we think it clear that the jury was not misled. Instead, it seems apparent that it followed a reasonable, layman's view of the instruction: that it should award to Mr. Sikes compensation for any actual losses suffered by him as a result of McGraw-Edison's breach of faith plus a reasonable amount as compensation for the unauthorized use of his device. So viewed and applied, the instruction is not improperly prejudicial to McGraw-Edison.

[5] Next complaint is made of the court's references to infringement and to unjust enrichment, as inappropriate to a breach of contract case. We have held otherwise as to trade secret matters, however, in *University Computing Co.* v. *Lykes-Youngstown Corp.*, 504 F.2d 518, 535-7 (5th Cir. 1974). And although *University Computing* is a Georgia diversity case, neither the course of its reasoning nor the authorities cited are limited to Georgia law.

[6] Next, McGraw-Edison complains that the instruction permits the jury to appropriate to Sikes all of its profits from the Graswhip, not merely those attributable

to the use of his device. We do not so read the instruction's language: "the amount of money by which the Defendant was unjustly enriched . . . *as a consequence* of Defendant's infringement" (emphasis added).

Finally, the charge is attacked for its failure to refer to the contract's two-year limitation on disclosure. Since, according to the agreement, McGraw-Edison could properly have used the Sikes' disclosures without his consent after two years had passed, it argues that the jury should have been permitted to consider only sales of the Graswhip that occurred during that period.

[7] The argument, while it possesses some plausibility, must be rejected on several grounds. In the first place, McGraw-Edison did not comply with the two-year clause that it seeks to press into service but rather breached it. Since it did so, the consequences that would have followed on its compliance cut little of a figure here. In the second, no man can say with certainty what might have happened had McGraw-Edison complied with the clause in either of the two modes open to it: obtaining Mr. Sikes' consent to use his device by agreeing with him on a royalty of some kind or biding its time while the two years passed before appropriating it. But had it done the former, it seems exceedingly unlikely that any such per-unit royalty as the parties might have agreed upon would have been so arranged as to terminate after two years or have been payable for any term other than the life of the Graswhip's saleability. And since an award to Mr. Sikes of an amount approximating what he would have received had a reasonable royalty been paid him is an appropriate measure of damages, *University Computing Co.*, 504 F.2d at 536-8, it is also appropriate to measure its amount by reference to the most likely period for which it would have been paid had McGraw-Edison complied with its obligations under the contract. As we shall see presently, this is what the jury apparently did. We find no fault with its approach.

[8] Coming, then, to the amount of the verdict, we do not find it "monstrous" or excessive at all. There was testimony that as of shortly before trial McGraw-Edison had sold 1,536,226 Graswhips. Dividing the $900,000 award by this figure produces a hypothetical royalty of 59 cents per unit. There was, as we have noted, evidence that Mr. Sikes had proposed a 50-cent per unit royalty[6] and received a reaction from McGraw-Edison that this was "about right." Expert testimony as to what a reasonable royalty would have been ranged from over a dollar per unit to ten cents. The jury verdict is well within that range.

AFFIRMED.

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[6] Plus a substantial cash payment, $50,000, characterized by McGraw-Edison as a little too high.

Charles L. SIKES and Arnold T. Sikes,
Plaintiffs-Appellees Cross-Appellants,

v.

McGRAW-EDISON COMPANY,
Defendant-Appellant Cross-Appellee.

No. 80-2089

United States Court of Appeals, Fifth Circuit.

March 25, 1982.

Developer of lawn trimmer brought action against manufacturer alleging wrongful appropriation of his trade secret and violation of nondisclosure agreement between parties. The United States District Court for the Western District of Texas, Lucius Desha Bunton, III, J., entered judgment on jury verdict for plaintiff, and the Court of Appeals affirmed at 665 F.2d 731. On petition for rehearing, the Court of Appeals, Gee, Circuit Judge, held that: (1) under Texas law, one who acquires trade secret knowledge in confidence may not turn it to his own use in breach of that confidence even though subsequent events make it available to rest of the world, and (2) under Texas law, there is not so rigid a distinction between new product ideas and trade secrets that, to be afforded protection, the secret must be used in one's business in sense that party seeking protection is manufacturing and selling a product by means of or incorporating secret in dispute.

Petition denied.

1. Torts — 10(5)

Under Texas law, one who acquires trade secret knowledge in confidence may not turn it to his own use in breach of that confidence even though subsequent events make it available to rest of the world.

2. Torts — 10(5)

Under Texas law, there is not so rigid a distinction between new product ideas and trade secrets that, to be afforded protection, the secert must be used in one's business in sense that party seeking protection is manufacturing and selling a product by means of or incorporating secret in dispute.

Haight, Hofeldt, Davis & Jambor, Edward A. Haight, Chicago, Ill., Cotton, Bledsoe, Tighe & Dawson, Charles Tighe, Midland, Tex., for McGraw Edison Co.

W. B. Browder, Jr., Midland, Tex., for Charles L. and Arnold T. Sikes.

Appeals from the United States District Court for the Western District of Texas.

ON PETITION FOR REHEARING

(Opinion January 14, 1982, 5 Cir., 1982, 665 F.2d 731)

Before GEE and RUBIN, Circuit Judges, and SPEARS*, District Judge.

GEE, Circuit Judge:

On petition for rehearing, appellant McGraw-Edison again presses upon us several contentions already argued. Two merit brief further discussion. Our opinion errs, we are told, in failing to distinguish the appropriation of a new product idea from that of a trade secret and in failing to recognize that the Sikes' device could not have been a trade secret since "once it is implemented it is exposed for the world to see . . . and to legally imitate." *Richter* v. *Westab*, 529 F.2d 896, 900 (5th Cir. 1976). These propositions are supported by various authorities cited but by none applying Texas law. Here is the rub.

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* District Judge of the Western District of Texas, sitting by designation.

For this is a diversity case. Like all trade secret actions, it derives from the common law of some state. Here the reference is to that of Texas, which has so far followed a course somewhat different from that of other states. In *Hyde Corp.* v. *Huffines,* 158 Tex. 566, 314 S.W.2d 763 (1958), for example, the court affirmed a perpetual injunction against one who had acquired the details of a device in confidence, even though they were disclosed in a patent application but denied as patent claims. In so doing, it made plain that under Texas law breach of confidence is the essence of such a cause of action:

> If these details as to construction were received by Hyde Corporation in confidence and that company later attempted to exploit them to Huffines' injury through a breach of confidence, an action lies, and it matters not whether the suit be designed as a "trade secret" case or as a suit for breach of confidence, which is a term commonly used by Huffines in describing his claim for relief.

Id. at 777.

In so doing, the Texas court expressly recognized that "[t]he effect of the injunction is to deprive Hyde Corporation of the right to do that which every other person could do. . . ." *Id.* at 778. Nevertheless, the court held it irrelevant that the confidant could have acquired and used the information legitimately when in fact it did so in breach of confidence. And in *K & G Oil Tool & Service Co.* v. *G & G Fishing Tool Service,* 158 Tex. 594, 314 S.W.2d 782 (1958), the court affirmed a judgment against one who learned the secrets of a tool by disassembling it in breach of a promise not to do so in the face of a jury finding that the internal construction of a tool could be determined by an examination ' the tool without disassembling it.

[1] It is thus the present law of Texas that one who acquires knowledge of this sort in confidence may not turn it to his own use in breach of that confidence even

though subsequent events make it available to the rest of the world.

[2] Nor does Texas law draw so rigid a distinction between new product ideas and trade secrets as that petitioner presses upon us: that the secret must be "used in one's business" in the sense that he is manufacturing and selling a product by means of or incorporating the secret in dispute. In *Hyde Corp.* v. *Huffines, supra,* the Texas court quotes section 757 of the first Restatement of Torts, from which the "used in one's business" language derives, but finds no difficulty in holding that a garbage compaction device was a "trade secret" in the hands of its inventor, though he had never manufactured or sold it commercially.

We do not say that the distinctions pressed upon us by petitioner are untenable or even that they may not present the more logical view. Indeed, the writer, as amicus, pressed the first upon the Texas court in the cases cited. He did not prevail, however, and neither proposition is the law of Texas.

It is, therefore, ORDERED that the petition for rehearing filed in the above entitled and numbered cause be and the same is hereby DENIED.

11914 Rennalee Loop
Austin, Texas 78753
January 23, 1976

Mr. William E. Doherty
McGraw-Edison Company
1801 North Stadium Boulevard
Columbia, Missouri 65201

Dear Mr. Doherty:

This letter is being transmitted in response to our recent discussion concerning your interest in obtaining more information about my grass trimming invention.

It is understood between us that, as embodied in this letter agreement, a disclosure contains information that is held to be confidential and proprietary by me. This information, and all drawings, models and documents of any type whatsoever embodying the information, will be held secret and confidential by McGraw-Edison Company, and will not be used for its own benefit without my prior written consent or as excepted below. McGraw-Edison Company will be expected to use only the same effort to avoid publication or dissemination of such confidential information as McGraw-Edison Company employs with respect to information of its own which it does not desire to be published or disseminated.

This confidential disclosure agreement shall remain in full force and effect between myself and McGraw-Edison Company for a period of two (2) years from date of disclosure, unless such submitted information can be shown by McGraw-Edison Company to have been in its possession, or of public knowledge, or to have been in the public domain prior to such submission, or if McGraw-Edison Company can show that it was put into the public domain subsequent to the disclosure through no fault or omission on the part of McGraw-Edison Company, or that it is later put in possession of such information by a third party under no obligation to me to maintain the information in confidence.

If the above is in accordance with your understanding, and is agreeable to McGraw-Edison Company, kindly so indicate by executing this original letter under the words "Accepted and Agreed To", retaining a duplicate for yourself, and returning the original to me.

Very truly yours,

Charles L. Sikes

Accepted and Areed To:
McGraw-Edison Company

PLAINTIFF'S EXHIBIT 14

Charles Sikes,
Austin, Texas

Background

This invention relates to an improved cutting apparatus for a rotary lawn trimmer. The prior art consists of device with a length of flexible non-metallic line coiled about a spool(s) with a free end extending out from the spool(s). The line, including the stored portion on the spool(s), is rotated by a motor and the free end(s) swung about with sufficient force to cut vegetation. When the free end(s) of the line become worn down, frayed, or is broken off, the free end(s) of the line is replinished by feeding line from the stored spool(s). The prior art devices while they definitely overcome the safety hazards of metal rotary blades, have several disadvantages. First of all the size of the motor capable to rotate the storage spool(s) is large. This large motor whips the free end(s) about with such force as to cause the line to be broken should the line become in more than minimal contact with a fixed object. Sometimes when the line is broken the remaining line slips back into the spool housing, thus requiring a disassembly of the spool housing in order to retrieve more line. Commonly when care has been taken to prevent breakage of the line, the free end of the line will become severely frayed thus reducing the cutting effectiveness of the line. For this reason the operator must carry suitable tools to permit periodic cutting off of the frayed end. After which more line must be fed out. Due primarily to the weight of motor, these previous devices have been rather heavy and bulky for the operator to use requiring the use of both hands to hold and operate. Again primarily due to the large motor, previous such devices have been what could be considered as an expensive lawn care tool to the

average home owner. Also previous devices have a cutting path diameter generally greater than one foot, thus preventing them from being able to trim vegetation in many small areas found around the home.

The disadvantages of the prior art are overcome with the invention presented here. More particularly, the present invention will be idealy suited for use in the periodic lawn maintenance. The small motor required permits a very small and light weight device which can easily be operated while holding the device with only one hand. When too much line becomes in contact with a fixed object such as a tree or house, the small motor will load down rather breaking the line, thus allowing the operator to reposition the device. The results is an almost zero breakage rate of the cutting line with no sacrifice in safety. Still provided is the quick, easy replacement of worn cutting line. Because of the shorter length of the cutting line used, line end fraying is not a problem and many of the small areas around the home mentioned above can be easily trimmed. Due to the smaller size of the motor and other key components the device described herein can be sold at a fraction of the cost of models presently commercially available.

Summary

The heart of the invention presented here is a light weight shaft with a specially designed hole through the shaft in such a manner as to facilitate a specially designed flexible nonmetalic cutting line. A properly selected motor is used to rotate the shaft and the line for the purpose of cutting vegetation. The cutting line, with one end enlarged is held in the rotating shaft by centrifugal force, thus allowing for the quick and easy replacement of the cutting line when it becomes worn.

PLAINTIFF'S EXHIBIT 7

EXPECTANT SALES — TWO YEAR PERIOD

Low	High
200,000	2,000,000

Basis

200,000,000	People in the USA
× .5	Faction of People who live in Houses
100,000,000	People who live in Houses
÷ 5	Average Number of People Per House
20,000,000	Houses

Assuming only 1% Home Owners buy, the 200,000 units will be sold.

Presently there around 200 people working in the Development Lab Bulding where I work. During the summer I have told about a dozen people about my invention. Presently it is conservatively estimated that there are well over 20 units being used by Lab Personnel.

Assuming 10% of the Home Owners buy, the 2,000,000 unit will be sold.

DEFENDANT'S EXHIBIT AA

United States Patent [19]

Jacyno et al.

[11] **4,118,865**

[45] **Oct. 10, 1978**

[54] **ASSEMBLY FOR REMOVABLY ATTACHING FLEXIBLE CUTTING LINE ELEMENT IN GRASS TRIMMER**

[75] Inventors: **Anthony Jacyno**, Columbia, Mo.; **Richard T. Smith**, St. Charles, Ill.

[73] Assignee: **McGraw-Edison Company**, Elgin, Ill.

[21] Appl. No.: **759,424**

[22] Filed: **Jan. 14, 1977**

[51] Int. Cl.[2] **B26B 27/00**; A01G 3/06

[52] U.S. Cl. **30/276**; 56/12.7

[58] Field of Search 30/276, 347; 56/12.7, 56/295, 29, 377, 15/179, 186, 194, 202

[56] **References Cited**

U.S. PATENT DOCUMENTS

2,382,292	8/1945	Carlson	339/276 T
3,104,510	9/1963	Voigt	30/347 X
3,402,542	9/1968	Johnston	56/295
3,474,608	10/1969	Frick	56/295
3,831,278	8/1974	Voglesonger	30/276
3,877,146	4/1975	Pittinger	30/276

FOREIGN PATENT DOCUMENTS

556,632	12/1974	Switzerland	30/276

Primary Examiner—Jimmy C. Peters
Attorney, Agent, or Firm—Ronald J. LaPorte; Jon Carl Gealow

[57] **ABSTRACT**

A grass trimmer employing a short length of nylon or the like line as the cutting element includes an assembly for removably attaching the line to a rotatable drive member. A hub member is coupled to the drive member for rotation. A post member extends from the free end of and parallel to the axis of rotation of the hub member. A rim portion also formed on the hub member, extends along a portion of the periphery thereof and defines a radially extending aperture therethrough. A length of line to be attached for rotation includes an eyelet connector at one end thereof. The opposite end of the line is received in the aperture in the rim portion so that the line extends radially outwardly from the hub member. The eyelet aperture receives the post member for removably attaching that end of the line to the hub member. A preferred embodiment of the cutting line has a triangular cross section to provide cutting edges extending the length of the line.

28 Claims, 8 Drawing Figures

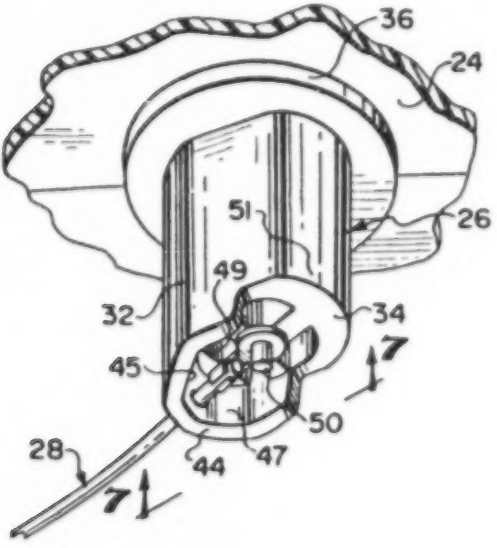


FIG. 1

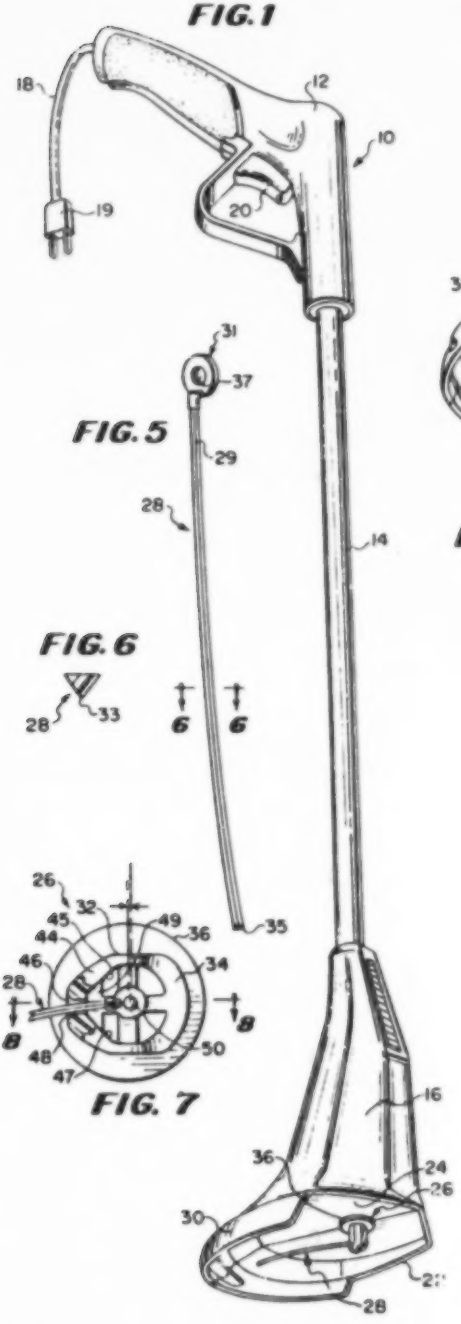


FIG. 2

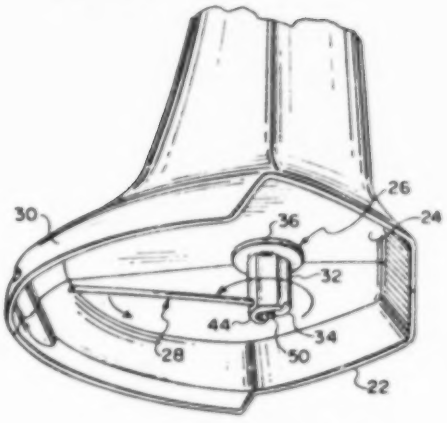


FIG. 3

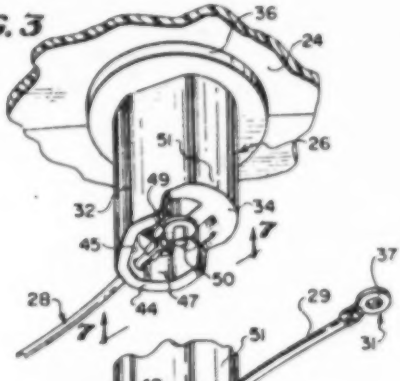


FIG. 4

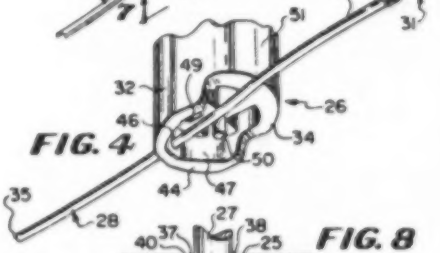
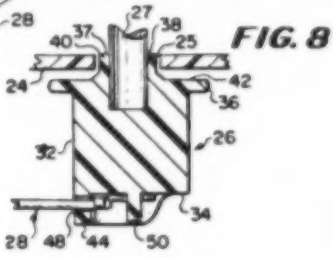


FIG. 5

FIG. 6

FIG. 7

FIG. 8



ASSEMBLY FOR REMOVABLY ATTACHING FLEXIBLE CUTTING LINE ELEMENT IN GRASS TRIMMER

BACKGROUND OF THE INVENTION

This invention relates generally to a grass edger or trimmer which employs a short length of plastic or the like cord as the grass cutting element and more particularly to an assembly for removably attaching the cord to a rotatably driven member of the trimmer.

Many different arrangements for attaching a length of cord to a rotatable member in a grass trimmer or edger are shown in the prior art. For example, in one embodiment shown in U.S. Pat. No. 3,708,967, issued Jan. 9, 1973, lengths of cutting line are looped through apertures spaced about the periphery of and tied to a rotatable disk. In an alternative embodiment of the device, radially extending apertures communicating with the peripheral apertures are also provided in the disk. Lengths of line, each having a knotted end, are received in the last mentioned apertures. The knots secure the lines to the disk with the aid of the centrifugal force produced during rotation thereof.

Still another arrangement for attaching short lengths of line to a rotating member in a grass trimmer is shown in U.S. Pat. No. 3,831,278, issued Aug. 27, 1974, wherein a diametrically extending channel is defined in the member. An axial recess communicating with the channel is also formed in the member. A knot or enlarged hub portion at the center of a length of cutting line is received in the recess with the opposite ends of the line extending radially outwardly through opposite ends of the channel. In this case, the central knot secures the line to the member against the centrifugal force created upon rotation of the member.

While the prior art arrangements described heretofore function satisfactorily for the most part to secure a length of cutting line to the rotating member of a grass edger or trimmer, they have certain disadvantages which make them undesirable. For instance, in the case of the first described embodiment of the U.S. Pat. No. 3,708,967 patent, tying the end of the cutting line to the rotating disk member can be time consuming as a typical nylon or plastic cutting element while being relatively flexible is sufficiently stiff to make it difficult to tie. The use of a knotted end on the cutting line to retain the line in position with respect to the rotating member provides no positive means for securing the line during non-use of the trimmer as it requires the centrifugal force generated by the rotating member to retain the line on the member.

In the case of the U.S. Pat. No. 3,831,278 device, it appears that mounting the cutting line properly on the rotating member could also be difficult and time consuming.

In addition to the above, it should be noted that in the prior art arrangements discussed, the cutting lines illustrated have had circular cross sections. The cutting surfaces therefore appear to be somewhat blunt and could thus be less effective against thick or high grass.

SUMMARY OF THE INVENTION

Accordingly, it is a primary object of the present invention to provide a new and improved assembly for removably attaching a cutting element comprising a relatively short length of cord or like, to a rotatably driven member of a grass edger or trimmer which overcomes the drawbacks of the prior arrangements discussed heretofore.

It is another object of the present invention to provide an assembly of the above-described type which is relatively simple in construction, yet effective in operation.

It is still another object of the present invention to provide a cutting line for a grass edger or trimmer of the above-described type that does not suffer the drawbacks of prior art cutting lines described heretofore.

Briefly, a preferred embodiment of the cutting line attachment assembly for a grass edger or trimmer according to the invention comprises a hub member which is driven rotatably by the drive shaft of the trimmer motor. The hub member includes a post extending outwardly from the free end, parallel to the axis of rotation thereof, but slightly off center with respect thereto. An outer rim portion is also formed on the periphery of the free end of the hub member. The rim portion is located on the side of the axis of rotation of the hub member opposite that of the post and partially surrounds the post. An aperture is defined in the rim portion which extends radially with respect to the hub member.

A length of cutting line to be attached to the hub member includes an eyelet connector affixed at one end of the line. The opposite end of the line is received in the aperture in the rim portion and extends radially outwardly therefrom. The post is received in the eyelet aperture for securing the first mentioned end of the line to the hub member. The off center post provides ease of attachment and removal of the eyelet connector thereto. The hub member may also be thickened on the opposite side from the line to provide a counterbalancing weight which minimizes any vibration due to the unbalanced weight of the line.

The exterior wall of the rim portion is tapered about the aperture to minimize the possibility of shearing the line when the latter engages objects such as stones, etc. during the use of the trimmer and the interior walls of the rim portion are angled also to provide for ease of insertion of the end of the cutting line into the aperture thereon.

A preferred embodiment of the cutting line or cord has a triangular cross section thereby providing a plurality of edges which efficiently slice through grass and the like vegetation.

DESCRIPTION OF THE DRAWING

In the drawing:

FIG. 1 is a perspective view of a lawn trimmer which uses a short length of plastic or the like line as the cutting element and a rotatably driven hub member including means for attaching the cutting line thereto according to the invention;

FIG. 2 is an enlarged fragmentary perspective view of the motor housing of the trimmer of FIG. 1 illustrating the cutting line element and hub member including the line attaching means according to the invention;

FIG. 3 is an enlarged fragmentary view of the cutting line element and hub member of FIG. 2;

FIG. 4 is a fragmentary view of the cutting line element and hub member of FIG. 3 illustrating the manner in which a length of cutting line is attached to the rotating hub member of the trimmer according to the invention;

FIG. 5 is a perspective view of a length of cutting line according to the invention.

FIG. 6 is a cross sectional view of the cutting line of FIG. 5 taken along the line 6—6;

FIG. 7 is an end view of the hub member of FIG. 3 taken along the line 7—7; and

FIG. 8 is a sectional view of the hub member of FIG. 6 taken along the lines 8—8.

DETAILED DESCRIPTION OF THE DRAWING

Referring now to the drawing in greater detail wherein like numerals have been employed throughout the various views to designate similar components, there is illustrated in FIG. 1, a grass trimmer designated generally by the numeral 10. The trimmer includes a handle portion 12 to which there is connected a shaft 14 of about three feet in length. At the opposite end of the shaft there is provided a motor housing 16. In the embodiment of the trimmer depicted in FIG. 1, a high r.p.m. electric AC motor (not shown) is mounted within the housing 16. An electrical cord 18 extends through the handle 12 and shaft 14 of the trimmer into housing 16 whereat it is connected to the motor to provide electrical energy thereto. Male plug 19 at the free end of the cord 18 is adapted for connection to a suitable source of electricity. A switch (not shown) is provided in handle 12 for operating the motor. A trigger type switch actuator 20 is used to operate the switch to control the application of energy to the motor.

The free end 22 of the motor housing includes a flat wall portion 24 defining an aperture 25 (FIG. 8) through which the rotatably driven drive shaft 27 of the motor extends.

A hub member 26 to which a relatively short length of cutting line 28 is attachable, is mounted on the free end of the motor drive shaft for rotation therewith. A shroud 30 integrally formed with the housing, partially surrounds the hub member and cutting line to control the direction in which grass clippings or other objects engaged by the spinning line 28 are projected.

The hub member 26 is preferably of molded plastic construction and includes a central body portion 32 extending outwardly from an enlarged flange portion 36. An axially extending recess 38 (FIG. 8) is defined in end 37 opposite free end 34 of the member for receiving the motor drive shaft 27. The hub member is attached to the drive shaft via conventional means, such as, for example, a pin or the like fastener. An extension portion 40 at end 37 of the hub member extends through the aperture in wall portion 24 of the housing so that surface 42 of the flange portion 36 is positioned adjacent thereto. The flange portion 36 of the hub member overlies aperture 25 in wall 24 of the housing to prevent grass clippings, etc., from entering the motor housing therethrough.

A rim portion 44 extends outwardly from and partially about the periphery of the free end 34 of the hub member 26. The rim portion defines a radially extending aperture 46 therein. The outer wall surface 48 of the rim portion surrounding the aperture 46 is tapered to eliminate sharp edges which could damage the plastic cutting line.

A cylindrically shaped post 50 having a predetermined diameter length extends outwardly from end 34 of the hub member substantially parallel to the axis of rotation thereof. The post 50 is positioned predeterminedly off center (see FIG. 7) with respect to the axis of rotation in the direction opposite the rim portion 44 along an imaginary line extending radially through the aperture 46 and post 50. The purpose of offsetting the post 50 in this manner is to permit more space for the user to attach the eyelet connector, thereby making attachment and removal of the line relatively simple. The post 50 can, however, be coincident with the axis of rotation of the hub member if desired. Also, the hub member is molded to provide an inherent counterbalancing effect for proper rotation upon attachment of cutting line 28 thereto. This is accomplished by the provision of a thickened portion 51 of the hub member on the side thereof opposite the rim portion 44.

The cutting line 28 according to the invention includes a relatively short (approximately three inches) piece of mono or multi-filament nylon or the like material having a looped end 29. In the preferred embodiment, shown best in FIG. 5, looped end 29 is provided by an eyelet connector 31 crimped onto the line end. The connector defines a circular aperture 37 having a diameter slightly larger than the diameter of post 50. Thus, upon receipt of the post 50 in aperture 37 of the connector there is a minimum of play therebetween. Looped end 29 can be provided in many other ways which will be understood by one skilled in the art.

The line 28 according to the invention has a triangular cross section (see FIG. 6) to provide three edges, such as 33, for slicing through grass or the like vegetation. The slicing edges 33 on line 28 provide for more efficient cutting of grass.

The cutting line is quickly and easily attached to the hub member 26. The manner of attachment of the line is illustrated in FIG. 4 of the drawing. To attach line 28, the free end 35 thereof is inserted from the post side of rim portion 44 through aperture 46 until the aperture 37 in eyelet connector 31 is aligned with post 50. To provide for ease of insertion of the free end 35 of the line into aperture 46 in the rim portion 44, the interior walls 45, 47 of the rim portion are angled toward the aperture 46. Also a third angled wall portion or ramp 49 is formed at the free end of the hub member adjacent walls 45, 47. The angled walls 45, 47 and ramp 49 converge toward the aperture 46 to provide a guide for the free end 35 of the cutting line 28. After the line is fed through the aperture, the eyelet is placed over the post so that the latter is received in aperture 37 (see FIGS. 3 and 7). The post 50 is sufficiently long, extending outwardly beyond the point of aperture 46 in the rim portion to require that the flexible line be bent to insert post 50 in eyelet aperture 37. In this fashion, once the eyelet connector is mounted on the post 50 as shown in FIGS. 3 and 7, it cannot inadvertently become detached from the hub member.

The assembly according to the invention thus provides a simple yet effective means for easily and quickly removably attaching a short length of nylon or the like cutting line to a rotatably driven member of a grass trimmer which overcomes the drawbacks of prior art arrangements described heretofore.

While a particular embodiment of the invention has been shown and described, it should be understood that the invention is not limited thereto as many modifications thereof may be made. It is therefore contemplated to cover by the present application any and all such modifications as fall within the true spirit and scope of the appended claims.

We claim:

1. In a grass trimmer having rotatable drive means and a cutting element comprising a relatively short length of non-metallic, flexible cutting line, a connector having an aperture of a predetermined shape defined

therein provided at a first end of said cutting line, an assembly for removably attaching the length of cutting line to said rotatable drive means for spinning said line, said assembly comprising: a hub member coupled to said drive means for rotation thereby, said hub member including a post extending outwardly from the free end thereof, said post being shaped complementarily to the shape of said aperture in said connector and dimensioned for receipt in said connector aperture, with limited play between said post and connector, and rim means extending outwardly from and along at least a portion of the free end of said hub member and being spaced from said post, said rim means defining an aperture extending substantially radially with respect to the axis of rotation of said hub member, the end of said length of cutting line opposite said connector being receivable in said radial aperture with the last-mentioned end extending radially outwardly from said rim means and said post being receivable in the aperture of said connector for removably attaching said length of cutting line to said hub member, the free end of said post extending outwardly from said hub member beyond the point at which the radially extending aperture in said rim means is defined to ensure that said length of cutting line remains secured to said hub member.

2. In a grass trimmer having rotatable drive means and a cutting element comprising a length of relatively flexible cutting line including loop means provided at one end thereof, spun at high speed, an assembly for removably attaching the cutting line to said rotatable drive means for spinning said line, said assembly comprising: a hub member coupled to said drive means for rotation thereby, said hub member including a post extending outwardly from the free end thereof and rim means extending outwardly from and along at least a portion of the free end of said hub member and being spaced from said post, said rim means defining an aperture extending substantially radially with respect to the axis of rotation of said hub member, the end of said length of cutting line means being receivable in said aperture with said last-mentioned end extending outwardly from said rim means and said post being receivable in said loop means for attaching said length of cutting line to said hub member, wherein said hub member includes a thickened portion on the side of said axis of rotation of said hub member opposite that of said rim means for counter-balancing said hub member upon attachment of said length of cutting line thereto.

3. In a grass trimmer having rotatable drive means and a cutting element comprising a length of relatively flexible cutting line including loop means provided at one end thereof, spun at high speed, an assembly for removably attaching the length of cutting line to said rotatable drive means for spinning said line, said assembly comprising: a hub member coupled to said drive means for rotation thereby, said hub member including a post extending outwardly from the free end thereof and rim means extending outwardly from and along at least a portion of the free end of said hub member and being spaced from said post, said rim means defining an aperture extending substantially radially with respect to the axis of rotation of said hub member, the end of said length of cutting line opposite said loop means being receivable in said aperture with said last-mentioned end extending outwardly from said rim means and said post being receivable in said loop means for attaching said length of cutting line to said hub member, wherein said post extends outwardly from said hub member substantially parallel to the axis of rotation thereof and is spaced from and on the side of said axis of rotation of said hub member opposite that of the rim means for easy attachment and removal of said end of said line including said loop means to said post.

4. In a grass trimmer having rotatable drive means and a cutting element comprising a length of relatively flexible cutting line including loop means provided at one end thereof, spun at high speed, an assembly for removably attaching the length of cutting line to said rotatable drive means for spinning said line, said assembly comprising: a hub member coupled to said drive means for rotation thereby, said hub member including a post extending outwardly from the free end thereof and rim means extending outwardly from and along at least a portion of the free end of said hub member and being spaced from said post, said rim means defining an aperture extending substantially radially with respect to the axis of rotation of said hub member, the end of said length of cutting line opposite said loop means being receivable in said aperture with said last-mentioned end extending outwardly from said rim means and said post being receivable in said loop means for attaching said length of cutting line to said hub member, wherein said hub member includes guide means provided therein for guiding said end of said cutting line into the aperture in said rim means.

5. An assembly as claimed in claim 4 wherein said guide means includes angled walls formed on said rim means and a ramp portion formed on the free end of said hub member, all of which converge toward said aperture.

6. An assembly as claimed in claim 1 wherein said hub member defines on the end thereof opposite said free end, an axially aligned recess for receiving therein said rotatable drive means and means for attaching said drive means to said hub member whereby the latter is driven rotatably thereby.

7. An assembly as claimed in claim 1 wherein said rim means includes an external wall opposite said post, the surface of which is tapered about said radially extending aperture to minimize shearing of said cutting line.

8. A trimmer for cutting grass or the like vegetation including in combination, rotatable drive means, a relatively short length of non-metallic, flexible cutting line, an eyelet connector having an aperture of a predetermined shape defined therein fixedly attached to a first end of said length of cutting line and a hub member coupled at one end to said rotatable drive means for rotation thereby including means for attaching said length of cutting line thereto, said attaching means including a post extending outwardly from the free end of said hub member substantially parallel to the axis of rotation thereof and rim means extending outwardly from and along at least a portion of the free end of said hub member and being spaced from said post, said rim means defining an aperture therein extending substantially radially with respect to the axis of rotation of said hub member, the end of the length of said cutting line opposite the first end thereof being received in said aperture with the last-mentioned end extending radially outwardly from said rim means and said post being shaped complementarily to the shape of said aperture in said connector for receipt in said connector aperture with limited play between said post and connector for removably attaching said length of line to said hub member, the free end of said post extending outwardly from said hub member beyond the point at which the

radially extending aperture in said rim means is defined to ensure that said length of cutting line remains secured to said hub member.

9. A trimmer for cutting grass or the like vegetation including in combination, rotatable drive means, a length of relatively flexible cutting line having loop means provided at a first end thereof and a hub member coupled at one end to said rotatable drive means for rotation thereby including means for attaching said cutting line thereto, said attaching means including a post extending outwardly from the free end of said hub member substantially parallel to the axis of rotation thereof and rim means extending outwardly from and along at least a portion of the free end of said hub member and being spaced from said post, said rim means defining an aperture therein extending substantially radially with respect to the axis of rotation of said hub member, the end of said cutting line opposite the end thereof including said loop means being received in said aperture with the last-mentioned end extending outwardly from said rim means and said post being received in said loop means for removably attaching said line to said hub member, wherein said loop means includes an eyelet connector having an aperture of a predetermined shape defined therein, said connector being affixed to one end of said cutting line, and wherein said post is shaped complementarily to the shape of said aperture in said connector but dimensionally slightly smaller than said aperture, whereby upon receipt of said post in said aperture there is a relatively small amount of play between said connector and said post.

10. A trimmer as claimed in claim 9 wherein said aperture defined in said eyelet connector is circular in shape with a diameter of a predetermined size and wherein said post has a circular cross section with a diameter slightly smaller than the diameter of the aperture of said eyelet connector.

11. A trimmer as claimed in claim 8 wherein said length of cutting line has a polygonal cross section thereby to provide a plurality of cutting edges extending the length thereof.

12. A trimmer as claimed in claim 11 wherein said length of cutting line has a triangular cross section.

13. A new and improved grass trimmer including in combination:

a cutting element comprising a short length of flexible, non-metallic line having a loop of a predetermined dimension provided at one end thereof;

a rotatably driven member including means for attaching said cutting element thereto, whereby said element is spun at high speed, said attaching means including a post extending outwardly from the free end of said member; and said post being complementarily shaped to the shape of said loop and dimensioned for receipt therein with limited play therebetween;

rim means extending outwardly from said free end of said member and spaced from said post, said rim means defining an aperture of a predetermined dimension extending substantially radially with respect to the axis of rotation of said member, the end of said cutting line opposite said loop being dimensioned for receipt in said radial aperture and extending through said aperture radially outwardly from said rim means and said loop receiving said post for removably attaching said line to said member, the free end of said post extending outwardly from said hub member beyond the point at which the radially extending aperture in said rim is defined to ensure that said cutting line remains attached to said hub member.

14. A new and improved grass trimmer including in combination:

a cutting element comprising a short length of relatively flexible line having loop means provided at one end thereof; and

a rotatably driven member including means for attaching said cutting element thereto, whereby said element is spun at high speed, said attaching means including a post extending outwardly from the free end of said member; and

rim means extending outwardly from said free end of said member and spaced from said post, said rim means defining an aperture extending substantially radially with respect to the axis of rotation of said member, the end of said cutting line opposite said loop means extending through said aperture radially outwardly from said rim means and said loop means receiving said post for removably attaching said line to said member, wherein said hub member includes a thickened portion on the side of the axis of rotation opposite said rim for counterbalancing said member upon attachment of said cutting line.

15. A new and improved grass trimmer including in combination:

a cutting element comprising a short length of relatively flexible line having loop means provided at one end thereof; and

a rotatably driven member including means for attaching said cutting element thereto, whereby said element is spun at high speed, said attaching means including a post extending outwardly from the free end of said member; and

rim means extending outwardly from said free end of said member and spaced from said post, said rim means defining an aperture extending substantially radially with respect to the axis of rotation of said member, the end of said cutting line opposite said loop means extending through said aperture radially outwardly from said rim means and said loop means receiving said post for removably attaching said line to said member, wherein said rotatably driven member includes guide means for guiding said end of said cutting line opposite said loop means into the aperture in said rim means, said guide means including angled walls formed on said rim means adjacent said aperture and a portion formed on said member, all of which converge toward said aperture in said rim means.

16. A new and improved grass trimmer including in combination:

a cutting element comprising a short length of relatively flexible line having loop means provided at one end thereof; and

a rotatably driven member including means for attaching said cutting element thereto, whereby said element is spun at high speed, said attaching means including a post extending outwardly from the free end of said member; and

rim means extending outwardly from said free end of said member and spaced from said post, said rim means defining an aperture extending substantially radially with respect to the axis of rotation of said member, the end of said cutting line opposite said loop means receiving said post for removably attaching said line to said member, wherein said post

has a circular cross section of a predetermined diameter and wherein said loop means includes an eyelet connector attached to said one end of said cutting line, said connector defining a circular aperture having a diameter slightly larger than the diameter of said post for receipt of the latter thereon whereby there is only a small amount of play between said connector and said post.

17. A grass trimmer as claimed in claim 16 wherein said rim means extends about a portion of the periphery of said member and wherein the free end of said post extends outwardly beyond the point at which the radially extending aperture in said rim means is defined, whereby the cutting line must be bent to insert said post into the aperture defined by said connector.

18. A grass trimmer as claimed in claim 16 wherein said cutting line has a triangular cross section thereby to provide three grass cutting edges extending the length thereof.

19. A grass trimmer as claimed in claim 16 further including a housing having motor means mounted thereon said motor means including rotatable drive shaft means, said housing having a wall portion, defining an aperture through which said drive shaft means extends and wherein said rotatably driven member is coupled to said drive shaft means at one end thereof for rotation therewith, said hub member including a flange portion formed at said one end and positioned in spaced relation with respect to said wall portion outside of said housing, said flange portion being sufficiently large to cover said aperture thereby to prevent grass and the like from entering said housing through said aperture.

20. A grass trimmer as claimed in claim 19 wherein said rotatably driven member is of a molded plastic construction with said post, said rim means and said flange portion being formed integrally therewith.

21. A trimmer for cutting grass or the like vegetation including in combination a rotatable drive means and a cutting element comprising a relatively short length of non-metallic, flexible cutting line of a predetermined cross sectional dimension having first securing means provided at one end thereof, and an assembly for removably attaching said length of cutting line to said rotatable drive means for spinning said cutting line, said assembly including a hub member coupled to said drive means for rotation thereby, said hub member including second securing means provided at the free end thereof and rim means extending outwardly from and along at least a portion of the free end of said hub member and being spaced from said second securing means, said rim means defining an aperture having a width only slightly larger than the cross sectional dimension of said line extending substantially radially with respect to the axis of rotation of said hub member, the end of said length of cutting line opposite said first securing means being receivable in said aperture with said last-mentioned end extending therethrough radially outwardly from said rim means a predetermined distance, the sidewise movement of said cutting line within said radial aperture being restricted because of the dimensional relation between the cross sectional dimension of said cutting line and the width of said radial aperture and said first and second securing means being engageable for removably attaching said length of cutting line to said hub member.

22. A trimmer as claimed in claim 21 wherein said first securing means comprises one of a loop and a post member formed at said one end of said length of line, wherein said second securing means comprises the other of said loop and post member formed at the free end of said hub member, in spaced relation to said rim means, and wherein said post member is receivable in said loop for removably attaching said length of cutting line to said hub member.

23. A trimmer as claimed in claim 22 wherein said post member is located on said hub member generally at the axis of rotation thereof and said loop is formed at said one end of said cutting line.

24. A trimmer as claimed in claim 23 wherein said loop comprises an eyelet connector coupled to said one end of said length of line, said eyelet connector having an aperture of dimension and shape complementary to that of said post member for receipt of said post member therein, thereby to removably attach said line to said hub member.

25. A trimmer for cutting grass or the like vegetation including in combination, rotatable drive means and a relatively short non-metallic, flexible cutting line element having first positive securing means provided thereon and an assembly for removably attaching said length of cutting line element to said rotatable drive means for spinning said cutting line element, said assembly including a hub member coupled to said drive means for rotation thereby, said hub member including second positive securing means provided on the free end thereof, said first and second positive securing means being engageable to positively retain said cutting line element on said hub member so that said element extends generally radially outwardly therefrom during or in the basence of rotation of said hub member, whereby a positive force is required to disengage said cutting line element from said hub member, said hub member further including rim means spaced from said second positive securing means, having a passage formed therein through which the end of said cutting line element opposite said first securing means passes radially outwardly from said hub member, said passage having a cross sectional dimension only slightly larger than that of said cutting line element to restrict the sidewise movement thereof.

26. A trimmer as claimed in claim 25 wherein said first positive securing means includes connector means attached to said cutting line element and wherein said second positive securing means includes means for receiving said connector for positive engagement therewith.

27. A trimmer as claimed in claim 25 wherein said hub member is generally cylindrical in construction and includes means thereon for counterbalancing said cutting line element.

28. A trimmer as claimed in claim 27 wherein said counterbalancing means includes an enlarged portion of said hub member on the side thereof opposite said cutting line element.

* * * * *

August 22, 1975

Mr. Joe Kindred, Sales Manager
McGraw-Edison Company
1801 North Stadium Blvd.
Columbia, Missouri 65201

Dear Mr. Kindred:

As requested in our phone conversation with Don Brisbin this afternoon, I am enclosing a description and sketch of the flail-type grass and weed cutter we discussed. If I can give you any other information please let me know. I look forward to hearing from you.

Very truly yours,

/s/ S. E. Schubert
S. E. Schubert
3600 Lakeview Road
North Little Rock, Ark. 72116

SES:mp
Encl.

I, Stephen E. Schubert, have made a flail-type grass edger and weed cutter by slightly modifying a Black and Deecker Model 8200 grass trimmer as follows:

1. Remove the steel cutter blade.
2. Remove the cutter blade shroud.
3. Drill a hole (about 3/32″) diametrically through the plastic blade holder. (Just below the bulge over which the blade snapped seems to work best.)
4. Thread a single piece (about 9″ long) of flexible plastic rod through this hole. (The plastic rod has been previously prepared with a knot or bulb on one end. 100# test or *heavier* monofilament plastic line seems to work best.)

You, thus, have a very effective flail-type grass and weed cutter which is light, easily maneuverable, safe to operate and low in cost.

Suggested improvements would be (1) a smooth-bottomed, saucer-shaped shroud and (2) preformed, packaged flails of superior wear-resistant plastic.

/s/ Stephen E. Schubert

Witness

/s/ Morris D. Cash

Specification:

The device for which this application is being submitted is a grass and weed cutter. It accomplishes this by utilizing one or more plastic flails (as contrasted to metal wires, rods or blades) attached to the rapidly rotating spindle of an electric motor.

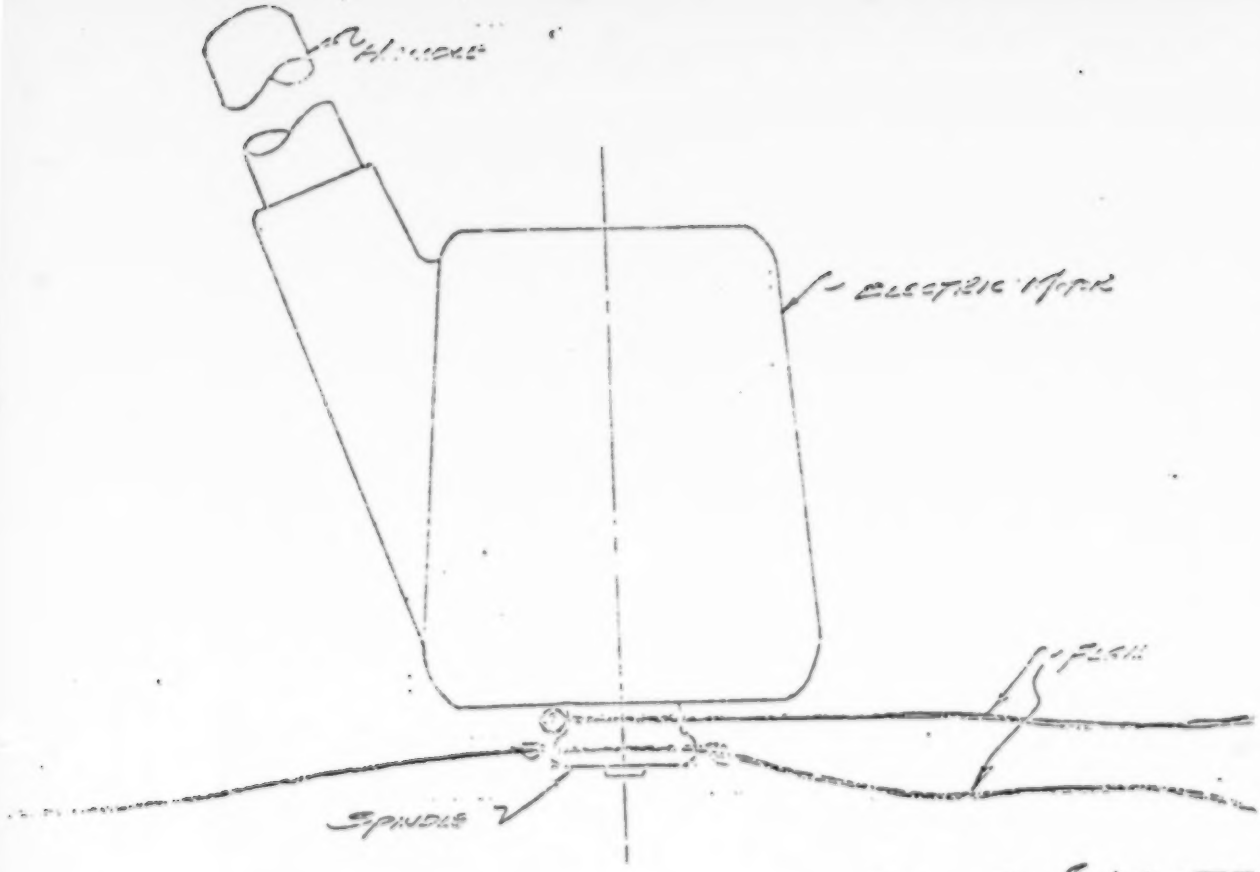
These flails are in relatively short pieces (as contrasted to being on a reel). The flails may be of ribbon, rod, tube, cord or line type wear-resistant plastic.

The flails may be attached to the spindle (a) through holes in the spindle by knotting, swaging or otherwise swelling one end of the flail, (b) by clamping on the spindle, (c) by nuts, bolts or screws, (d) in slots, (e) looping or tying on the spindle.

/s/ Stephen E. Schubert

Witness

/s/ Morris D. Cash



Stephen E. Schubert

CHARLES L. SIKES, the witness hereinbefore named, after having been first duly cautioned and sworn to tell the truth, the whole truth, and nothing but the truth, testified on his oath, as follows, on:

Direct Examination By Mr. Browder.

Q What is your name, please, sir?
A Charles Lee Sikes.

• • • • •

Q Then what did you do?
A Then I believe I went home to my, to visit my family in Abilene, and this would have had to have been probably in February. And I got my daddy's edger out to look at that motor because I felt like the motor I had seen on his device was the most optimal, so I did some more experimenting with his motor, using my new plastic holder. And he very much liked that tool that he had there in its original fashion so I could not persuade him to sell it to me, so I got the specifications off of the motor, that is the amperage, rpms of the motor, and when I got back to Austin I began to go to stores and look for that kind of a motor. Since I had already found that high rpm motors are most commonly found in edger devices I went to the garden department and began to look for a high rpm motor on an edger device, and at this time is when I discovered, became familiar with for the first time what is now known as the Black & Decker 8200. And the label on there showed that that motor had all the right things for me at that time.
Q Did you use that motor later?
A Yes, I did.
Q All right. What did you do with your shaft? What did you finally do, how did you do it to connect your line?
A Well, my—I drilled a hole in the shaft and then I enlarged the end of the monofilament line and I slipped the monofilament line through the hole in the shaft.

ALLEN BRUNE, the witness hereinbefore named, after having been first duly cautioned and sworn to tell the truth, the whole truth, and nothing but the truth, testified on his oath, as follows, on:

Direct Examination By Mr. McKinney.

Q Will you state your full name, please?
A Robert Allen Brune, Jr.
Q Where do you live, Mr. Brune?
A In Austin, Texas.
Q How long have you lived there?
A About 14 years, since I moved from West Texas. Most of my adult life.
Q And by whom are you employed at the present time?
A Havatec, Inc., consulting engineers.
Q Where is that company located?
A In Austin, Texas.
Q What is your relationship to the company?
A I am co-owner there. My partner and I own the company.

• • • • •

Recross-Examination By Mr. Tighe.

Q The Schubert, you indicated that you hadn't seen any single line cutter. The Schubert is a single line cutter, is it not?
A In his word description, yes.
Q Well, you were shown, you were asked to look at the pictures and I thought we cleared that up before. It is obvious to you as an intelligent person that what he is showing on the configuration is simply the possibility, you understand that, do you not? He is not suggesting that you have 3 lines coming out of that shaft, and you know that, don't you?
A I think he means that this was his attempt at a disclosure to try and obtain a patent so he was trying to keep it broad here.
Q He was showing both configurations, wasn't he?
A That's what I would think.

Q All right. But you understood that one of the configurations he is showing is to have a single monofilament line coming out of the shaft?

A. Yes. That is one.

Q All right. And in that sense don't you agree that if you had seen the—you indicated that you were really impressed with the Sikes thing, don't you agree that if you had seen the Schubert thing and realized it used the Black & Decker that you would be similarily surprised?

A Well, yes. I didn't realize, as you know, and Charlie showed a finished model as opposed to a patent, attempted disclosure here.

Q I realize that, but in your position if you had seen the drawing and knew it was a Black & Decker 8200 that he was using, you would be just as impressed with that as you would be with looking at the model, would you not?

A I don't think generally that much information, I would say, yes, I would agree the concept is the same but much more impressive to see it as a finished device.

Q We can agree that the concept is exactly the same, can we not?

A I would think so. Their basic concept.

* * * * *

The Court: That will be fine.

Mr. Tighe: I now offer portions of the deposition testimony of Stephen Schubert that was taken on March 24, 1980 in North Carolina. Beginning on Page 3, Line 17.

"Q Mr. Schubert, what is your full name, for the purposes of this record?

A Stephen Ernest Schubert.

* * * * *

Q When you first did this, how long a piece of monofilament line did you use?

A We tried a number of different lengths. It seems like we started off with one about 4 inches long; we tried them all the way up to 9 inches long. I think I eventually concluded that about 6 inches was about the best length.

Q When you say 6 inches on your Page 4 of this exhibit, you are talking about from the bulb to the end of it?

A Right.

Q So, if that was it, it would make a circle of diameter somewhat less than 12 inches, depending upon the width of the spindle?

A Uh-huh.

Q Or the spool?

A Yes, sir.

Q But you spent time experimenting all the way from 4 inches to about 9 inches and found that about 6 inches was the optimum number?

A As far as I could tell.

Q In what way did it seem the best?

A The 9-inch length, the motor does not have the strength to keep that twirling out at a radius from the spool and it sort of bends back and gets tangled up. The nylon will wear off from the end, so that the 6 inches gives you a little bit of wear, quite a little bit of wear until you have to replace it.

Q Is it hard to replace that?

A No, you take one out and put the other one right in.

Q You said a while ago, 'We tried', did somebody else work with you or is that the editorial 'we'?

A No, my older son was at the house in North Little Rock and it was actually his idea to turn a glass upside down and put the bulb on the end of the plastic line.

Q As you experimented with different lengths of that line, did you also experiment with different sizes of line?

A Oh, yes, sir.

Q What range of sizes of lines did you experiment with?

A From rather fine fishing molofilament fishing line up to these nylon data processing posts.

Q How would they compare to say 150-pound test monofilament line?

A They are considerably heavier.

Q But you found that to be as good as anyhing else?
A (Witness nods affirmatively.)
Q As you worked on this, did you have neighbors that saw it and became interested in it?
A Definitely, I don't know that the work was still continuing, I know we took one to a pool party one time and trimmed the whole edge of the lawn.
Q Were people interested in it?
A Oh, yes, quite intrigued with it.
Q This pool party you are talking about, were quite a few people there?
A 20.

• • • • •

Q So you found that the best thing was to have simply a single length of monofilament line approximately 6 inches long with a bulb on one end to keep it from going through the spindle as it rotates?
A Yes, sir.
Q What holds it in place as it rotates?
A Centrifugal force.
Q Insofar as the size of the hole that you drilled through the spool or the shaft, did you experiment with different sizes of the hole?
A Yes, sir, as I went to larger and larger pieces of nylon, I increased the size of the hole.
Q Did you do anything else to the hole, did you bevel the hole or round it out or do anything like that to it?
A No, I don't think so.
Q Did that seem to have any adverse effect on how long a particular length would last, the fact that the end was not beveled on either side of the spool where it came out of the spool?
A It, in use, bevels itself.
Q What do you mean by that?
A It wears.
Q Insofar as the location of the hole through the spindle or shaft, did you experiment with putting that hole at different places and by that I am talking about in the head part of it or the more narrow part of it?
A Yes, sir, I did.

Q Did you at different times have holes in both of those areas?

A Uh, huh, yes, sir.

Q What did you find?

A Not any real difference. The main reason I think I drilled it through the bottom first, not knowing where the steel shaft came in down there, and later on I drilled up here and the steel shaft was not there; this piece must go up inside.

Q So you first drilled it closest to the ground?

A Right.

* * * * *

The Court: Members of the jury: you have heard the evidence and the arguments, and it becomes my duty now to give the instructions as to the law which I believe applicable to this particular case.

* * * * *

The plaintiffs, Charles L. and Arnold Sikes claim that they developed a rotary lawn trimmer device which was different from and an improvement upon all lawn trimming devices then being produced and marketed. They also claim that they in confidence disclosed such lawn trimming device and design to agents of the defendant, McGraw-Edison Company, who appropriated such design to their use without paying appropriate compensation to them. The Sikes brothers claim that such actions on the part of McGraw-Edison constitute the appropriation and wrongful use of a trade secret. The defendant says and contends that any information furnished it by the plaintiffs, Sikes brothers, was not a trade secret. The defendant further says and claims that under the written agreement with the plaintiffs dated January 23, 1976, its only obligation was to maintain the confidentiality of that information claimed by the Sikes brothers to be a trade secret that was not already in McGraw-Edison's possession or of public knowledge, or in the public domain prior to January 23, 1976. Further the defendant states that its Graswip, that is that thing that has been intro-

duced here, does not embody or disclose the trade secrets, if any, provided by the plaintiffs.

You are instructed that a trade secret may be a device or process which is patentable, but it need not be that. It may be a device or process which is clearly anticipated in the prior art or one which is merely a mechanical improvement that a good mechanic can make. Matters of general knowledge in an industry cannot be taken by one person as a trade secret, nor as a simple and obvious change in an existing device or process entitled to protection as a trade secret. There must be some improvement which gives the one using the device or process an opportunity to obtain an advantage over competitors who do not know of the device or process or uses.

• • • • •

Patent Specification

of

Charles L. Sikes

Entitled

"LAWN TRIMMER"

Abstract of the Disclosure

A rotary lawn trimmer that can be easily hand held and enable the user to trim the lawn and shrubs in hard to reach places. The trimmer includes a housing for holding a drive motor. A holder is coupled to the motor in such a manner so that it can be rotated by the motor. An elongated flail is arranged within a bore provided within the holder. The flail extends through the bore so that an enlarged end of the flail contacts the holder and the other end of the flail freely extends from the bore. Thus, as the holder is rotated by the motor, the resulting whipping action of the flail can be utilized for cutting the lawn and shrubs.

Background of the Invention

The present invention relates to an improved cutting apparatus for a rotary lawn trimmer.

The standard types of lawn trimming mechanisms usually incorporate metallic cutting blades which are rotated about an axis for trimming the lawn. The utilization of such metallic cutting blades, however, presents several undesirable disadvantages, the most significant of which is the resulting safety hazard. It is also difficult to utilize and maneuver such cutting mechanisms in small areas, thereby requiring that such areas be trimmed by a hand held cutting shears.

In order to overcome the safety hazard involved with the metallic cutter blades, a cutting mechanism has been developed and commercially marketed in which a length of flexible non-metallic line is rotated about an axis so as

to act as a flail for the cutting of vegetation, e.g., lawn and shrubs. In this device, the flexible line is coiled about a spool with a free end entending out from the spool. The line, including the stored portion on the spool, is rotated by a motor positioned within the housing of the cutting mechanism. The free end the line is swung about with sufficient force so as to be able to cut the vegetation. When the free end of the line becomes worn down, frayed or otherwise broken, the free end of the line is replenished by releasing more line from the storage spool and cutting off the used portion of the line.

While this flail type cutting device overcomes the safety hazards of metal cutting blades, the mechanism still prevents several disadvantages. First, since the motor must rotate the storage spool in addition to the line, a sufficiently large motor must be utilized. This large motor whips the free end about with such a force so that if the line comes into more than minimal contact with a fixed object the line is easily broken. When the line does break, it is possible for the line to slip back into the spool housing thereby requiring that the housing be disassembled in order to retrieve more line. Additionally, when the line does become frayed, from extensive use, in order to replenish the line, the operator must carry suitable tools for cutting off the worn line and for feeding out new line.

Since this type of cutting mechanism requires a significantly large motor, the device has been relatively heavy and bulky for the operator to utilize thereby requiring the use of both hands to hold and operate the tool. Due to the necessity of having a relatively large motor, such devices also have been generally too expensive as a lawn care tool for the average homeowner. Furthermore, due to the utilization of the larger motor and the necessity of storing the storage spool, the overall diameter of the cutting device has generally been greater than one foot, thereby preventing the device from being capable of trimming vegetation in small areas found around the home.

Other types of cutting flail mechanisms have also been previously developed. These mechanisms, however, have generally been developed for commercial purposes and have included a plurality of flails mounted along either one or a plurality of rotatable shafts. Such mechanisms are illustrated in Canadian Patent No. 467,333 issued to Wallace and U. S. Patent Nos. 3,190,064 issued to Wenzel et al and 3,765,491 issued to van der Lely et al. None of these cutting mechanisms, however, are of a type which would be appealable to the average homeowner for utilization in common lawn care.

Summary of the Invention

The present invention is concerned with providing an improved rotary lawn trimmer for utilization in normal home lawn care which avoids the use of metal cutting blades.

Another object of the present invention is to provide a flail cutting mechanism which is ideally suited for use by the average homeowner in periodic lawn maintenance.

A further object of the present invention is to provide a flail cutting mechanism which only requires the utilization of a small motor thereby providing a small and light weight device which can be easily operated while holding the device with only one hand.

These objectives can be accomplished in utilizing the light weight lawn trimmer of the present invention. This mechanism includes a light weight holder having a bore passing entirely through the holder, which bore is specially designed so as to receive a flexible non-metallic cutting flail. The flail extends through the bore with an enlarged end of the flail in contact with the holder and the other end of the flail extending freely from the bore. A properly selected light weight motor can be utilized for rotating the shaft and the flail in order to enable the mechanism to be utilized in cutting vegetation. The flail is held within the rotating holder by the centrifugal force which is

created as the holder is rotated. Thus, when the flail becomes frayed it can be easily and quickly replaced merely by removing the worn flail and replacing it with a new flail.

Since only a small light weight motor is required for rotating the holder and flail, when the flail comes into contact with a fixed object, such as a tree or a house, the motor is loaded down and slows rather than causing a breakage in the flail. It, therefore, is only necessary for the operator to reposition the device and there is no necessity for replacing the flail upon such an occurrence. This results in a substantially zero breakage rate of the cutting flail without any sacrifice in the cutting efficiency or safety in utilizing the trimmer. Furthermore, due to the small size of the motor and the other components of the trimmer, the trimmer can be utilized in relatively small spaces.

Additionally, the trimmer can be manufactured and sold at a relatively small fraction of the cost of previously available commercial cutting mechanisms.

Brief Description of the Drawings

Figure 1 is a perspective view of a lawn trimmer in accordance with the present invention, with a portion of the housing being cut away in order to allow other portions to be more clearly seen.

Figure 2 is a side elevational view of the flail holder and coupling shaft utilized in the lawn trimmer illustrated in Figure 1.

Figure 3 is a bottom plan view of the holder illustrated in Figure 2.

Figure 4 is a side elevational view of the flail which is inserted within the holder in Figure 1.

Description of the Preferred Embodiment

The lawn trimmer illustrated in Figure 1 is a light weight mechanism which can be hand held for trimming

vegetation. The trimmer includes a housing 1 which is mounted at a lower end of a rod 4. A handle 5 is attached to the upper end of rod 4 and has a power cord 6 extending from it .

A motor 2 is mounted within housing 1. A shaft 8 which is rotated by motor 2 extends from the lower extremity of the motor. A holder 3 is attached at the lower end of shaft 8 and is thereby coupled to motor 2 so that it can be rotated by the motor.

Holder 3 is provided with a laterally extending bore 9 which is open at both ends, as shown in Figures 2 and 3. A flail 7, as shown in Figure 4, can be arranged within bore 9 so as to have its enlarged end 10 in contact with the holder and its other end freely extending from the holder. As holder 3 is rotated, the free end of flail 7 is whipped about and serves to cut any vegetation which comes within its path.

When the free end of flail 7 becomes worn, the flail can be easily replaced merely by withdrawing it from bore 9 and inserting a new flail in its place. During utilization, however, the flail is securely held in place due to the centrifugal force which is created during the rotation of the holder. Thus, the user of the lawn trimming mechanism need only carry a supply of additional flails and there is no need for him to have any tools in order to replace the flail whenever it becomes worn.

Flail 7 is formed of an elongated member which has a cross-sectional dimension just slightly less than the cross-sectional dimension of bore 9. At one end of the flail, a circular head 10 is provided so as to prevent the flail from entirely slipping through bore 9. During utilization, head 10 is urged into contact with the outer side of bore 9 as the free end is whipped about.

It is noted that the above description and the accompanying drawings are provided merely to present an exemplary embodiment of the present invention and that additional modifications of this embodiment are possible with-

in the scope of this invention without deviating from the spirit thereof.

CLAIMS:

1. A rotary lawn trimming apparatus comprising:

a housing for holding a drive motor;

a drive motor;

a holder coupled to said motor so as to be capable of being rotated by said motor, said holder having a bore extending in a lateral direction entirely through said holder; and,

an elongated flail having one of its ends enlarged so as to have a larger cross-section than the remaining portion of said flail, said flail being substantially longer than said bore within said holder and said flail being capable of being arranged within said bore with its enlarged end in contact with said holder and its other end freely extending from said bore.

2. Apparatus as defined in claim 1 wherein said flail is formed of an elongated cylindrical member with a circular head constituting its enlarged end.

3. An apparatus as defined in claim 2 wherein said flail is formed of a non-metallic flexible material.

DECLARATION AND POWER OF ATTORNEY

I, Charles L. Sikes, declare that I am a citizen of the United States of America, residing at 11914 Rennalee Loop, Austin, Texas; that I have read the foregoing specifications and claims, and I verily believe I am the original, first and sole inventor of the invention or discovery in "Lawn Trimmer" described and claimed therein; that I do not know and do not believe that this invention was ever known or used before my invention or discovery thereof, or patented or described in any printed publication in any country before my invention or discovery thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that this invention or discovery has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months before this application; and that no application for patent or inventor's certificate on this invention or discovery has been filed by me or my representatives or assigns in any country foreign to the United States, except as follows:

None

And I hereby appoint Gary M. Hoffman, Registration No. 26411 and the firm of Watson, Cole, Grindle & Watson, 1909 K Street, N.W., Washington, D.C. 20006, Registration No. 11307, my attorneys with full power of substitution and revocation to prosecute this application to transact all business in the Patent and Trademark Office connected therewith and to receive all correspondence in connection therewith.

The undersigned petitioner declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements

and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: February 3, 1976

Inventor: Charles Lee Sikes

Post Office Address: 11914 Rennalee Loop
Austin, Texas 78753

FIG. 1.

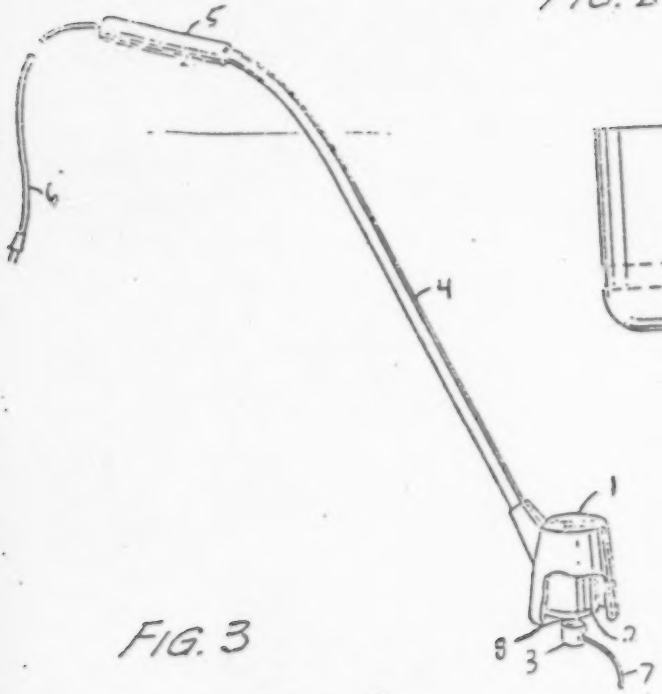


FIG. 2

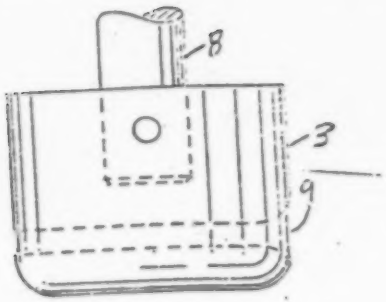


FIG. 3

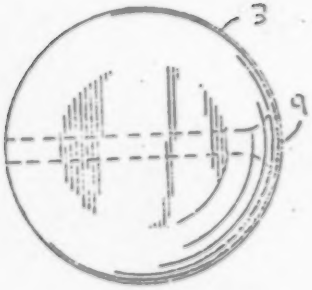


FIG. 4

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Charles SIKES
Serial No. 656,846
Filed February 10, 1976
LAWN TRIMMER

Group 334
Exr. R. T. Stouffer
March 11, 1977

• • • • • • • •

The Honorable Commissioner of Patents & Trademarks
Washington, D. C. 20231

Sir:

A M E N D M E N T

In response to the Office action of November 11, 1976, the time period for response to which has been extended by one month, please amend the above-identified application as follows:

IN THE CLAIMS:

1. (Twice Amended) A rotary lawn trimming apparatus comprising:

a housing for holding a drive motor;

a drive motor:

a holder coupled to said motor so as to be capable of being rotated by said motor, said holder having a bore extending in a lateral direction entirely through said holder; and,

an elongated flail having one of its ends enlarged so as to have a larger cross-section than the remaining portion of said flail, said flail being substantially longer than said bore within said holder and said flail being capable of being arranged so as to extend through the entire extent of said bore with its enlarged end in contact with said

holder at one end of said bore and its other end freely extending from the other end of said bore *and said flail being formed of a flexible material such that as the flail is rotated with said holder there occurs a whipping action that acts to cut the lawn.*

REMARKS

The Office action of November 11, 1976, has been received and its contents carefully considered.

Claim 1 has been amended in order to even more clearly point out the novel contributions of the present invention.

Claims 1 through 3 were rejected under 53 U.S.C. §103 as being unpatentable over the patent to Voglesonger in view of the patents to Langenstein and Freese. This rejection is respectfully traversed.

The present invention involves a novel construction for a light-weight rotary lawn trimmer. As with the trimmers disclosed by the patents to Voglesonger and Langenstein, the cutting action is provided by the rotary whipping motion imparted to a flail extending from a holder at the bottom of the trimmer. The construction of the flail and the holder for supporting the flail of the present invention, however, is entirely different from those flails and holders illustrated in the patents to Voglesonger and Langenstein. In accordance with the trimmer of the present invention, the holder which is mounted on the bottom of the trimmer, has a bore which laterally extends through the entire holder. The flail, which has an enlarged portion at one end, is then inserted from the outer side of the holder through the bore so that the enlarged end is in contact with one side of the holder and the opposite end of the flail freely extends from the other side of the holder. Since the flail is flexible, as it is rotated a whipping action occurs and the flail is then capable of cutting grass and trimming small shrubs.

In the grass trimmer illustrated in the patent to Voglesonger, a rotatable central holder is mounted on the bottom of the trimmer. This holder has a central cavity through which a two-sided flail member 74 can be inserted. This flail member has two flail sections which extend from a central portion (72, 81). In order to insert this flail into the holder, it is necessary to remove the holder from mounting member 67 to insert each of the flail sections through one of the bores in the holder while pressing down on the central disk of the flail member. After the flail sections have been threaded through the bores, the holder is then screwed back onto mounting member 67A.

In the patent to Langenstein, a grass trimmer is provided with a rotatable flail 2 which extends from a spool 3 of flail material. While it is true as pointed out in the Office action, that this patent does disclose a trimmer in which a flail only extends from one side, the flail is part of a continuous length of flail material. As the end portion of the flail becomes worn, a new section of flail material is withdrawn from the spool and the worn section is cut off. Thus, this patent fails to disclose a holder having a laterally extending bore through which an individual flail member can be inserted with the free end of the flail extending from one side of the holder.

While it has been suggested in the Office action that it would be obvious to change the flail arrangement shown in the patent to Voglesonger so that it extends in only one direction from the holder, as taught by the patent to Langenstein, it is submitted that the proposed modification is purely based upon the hindsight knowledge obtained from studying the present application. It is submitted that the only modification which would be suggested by viewing the teachings of the patents to Voglesonger and Langenstein would be to replace the flail and holder illustrated in the patent to Voglesonger by a continuous spool of flail material such as illustrated by the patent to Langenstein. Obviously such a modification is entirely different from the arrangement of the present invention.

Further reliance has been placed in the Office action upon the patent to Freese. First, it is noted that contrary to the contention in the Office action, this patent does not disclose flails such as those utilized in accordance with the present invention. The patent discloses a series of spiral wire beaters which are entirely different from the flexible flail members which extend from the holder of the grass trimmer of the present invention. Only by utilizing flexible members can the whipping action and the desired resulting cutting be obtained. Thus the disclosure of the teachings of the patent to Freese appear to be totally irrelevant to the present invention.

Moreover, with respect to the patent to Freese, it is noted that the wire beaters must be inserted through a central cavity in the holder, similar to the manner of inserting the flails in accordance with the teachings of the patent to Voglesonger. Thus, the teachings of the patent to Freese fail to overcome those problems inherent in utilizing the holder and flail arrangement disclosed by the patent to Voglesonger. Thus, even if one of ordinary skill in the art would consider the teachings of the patent to Freese in order to make it more convenient to insert and replace flails in a grass trimmer, the patent to Freese would not provide for a more simplistic system than already available in the patent to Voglesonger. Moreover, the patent to Freese fails to supply the deficiencies of the applied patents to Voglesonger and Langenstein with respect to the present invention.

Consequently even if the patents to Voglesonger, Langenstein and Freese are taken in combination, they would still fail to either teach or suggest the present invention as defined by claim 1. Inasmuch as claims 2 and 3 depend from claim 1, these claims also patentably distinguish over the combined teachings of the applied patents.

Since the patents to Buchanan and Steiert, which have only been cited of interest and not applied, do not appear to be any more pertinent to the present invention than the applied references, a discussion of these patents appears to be unnecessary.

Since claims 1 through 3 patentably distinguish over the prior art of record, it is respectfully requested that these claims be allowed and that the application be passed to issue.

Respectfully submitted,

WATSON, COLE, GRINDLE & WATSON
Attorneys for Charles Sikes

/s/ Gary M. Hoffman
Gary M. Hoffman

Reg. No. 26411
202/628-0088

Opposition

Office · U.S.
FILED
JUN 7 1982
ALEXANDER L. STEVAS,
CLERK

No. 81-2053

IN THE
Supreme Court of the United States
OCTOBER TERM, 1981

MCGRAW-EDISON COMPANY,
Petitioner,

v.

CHARLES L. SIKES, *et al.*,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

---

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether it was proper for the Fifth Circuit to hold that Petitioner's contractual rights, pursuant to the confidential disclosure agreement whereby Respondents disclosed proprietary intellectual property to Petitioner, were recognized and fairly protected in the trial of this case.

2. Whether it was proper for the Fifth Circuit to enforce Texas trade secret law in this case even though Respondents' intellectual property was such as would be disclosed in the normal process of exploitation.

LIST OF PARTIES

1. Charles Sikes, Respondent.
2. Arnold Sikes, Respondent.
3. McGraw-Edison Company, Petitioner.*

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* Pursuant to Rule 28.1, Petitioner, McGraw-Edison Company, in its Petition For a Writ of Certiorari, has included a listing naming all parent companies, subsidiaries (except wholly owned subsidiaries) and affiliates.

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On Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

---

BRIEF IN OPPOSITION

Respondents, Charles and Arnold Sikes, respectfully pray that the petition for writ of certiorari to the United States Court of Appeals for the Fifth Circuit be denied.

OPINIONS BELOW

The opinion of the Court of Appeals for the Fifth Circuit is reported at 665 F.2d 731. The written opinion of the Court of Appeals for the Fifth Circuit denying rehearing is reported at 671 F.2d 150. Both of such opinions have been reproduced in the Appendix to Petitioner's brief.

JURISDICTION

The judgment of the Court of Appeals for the Fifth Circuit was entered on January 14, 1982. The petition for rehearing was denied on March 25, 1982. The jurisdiction of this Court arises under 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

A. Course of Proceedings.

This case was originally filed by Respondents in a state district court in Midland, Midland County, Texas. It was removed to the United States District Court, Western District, Midland-Odessa Division, by Petitioner, on grounds of diversity. The case was tried to a jury with separate trials on liability and damages. In the first trial, on liability, the jury, in answer to a general charge, found for Respondents. The same jury, in a second trial, on damages, returned a verdict in favor of Respondents in the sum of $900,000. In accordance with those verdicts the trial court entered judgment in favor of Respondents for $900,000.

Petitioner appealed the judgment of the trial court to the Court of Appeals for the Fifth Circuit. Respondents cross-appealed presenting points of error relating to the damages portion of the trial. As noted by the Fifth Circuit in its original opinion, Respondents stated that they would waive their cross-appeal in the event the judgment of the trial was affirmed as to liability. The Fifth Circuit affirmed the judgment of the trial court against Petitioner (*Sikes v. Edison-McGraw Company*, 665 F.2d 731 [5 Cir. 1982]), and held that "[s]ince we do affirm, it [Respondents' cross-appeal] is waived unless the Supreme Court decides otherwise."

In answer to Petitioner's petition for rehearing, the Fifth Circuit rendered a second written opinion. By written opinion dated March 25, 1982, the Fifth Circuit ordered that the petition for rehearing be denied.

Lastly, Petitioner filed before this Court its Petition for a Writ of Certiorari to the United States Court of

Appeals for the Fifth Circuit, which represents the status of this case as it now stands for consideration by this Court.

B. Statement of Facts.

Charles Sikes first observed the now famous "Weed Eater" grass cutting tool in late 1974 (TR 55). Being a "tinkerer type," and being an electrical engineer who had some training in mechanical engineering, he began to experiment with various types of motors and various ways of using a monofilament line to develop a light-weight grass trimmer which could fit where the Weed Eater could not, and in which the cutting line could be easily replaced (TR 56-59, 63, 65-70).

Sikes developed a tool which was vastly different from other tools then on the market (TR 106). He then set out to find a manufacturer for his tool, and that search finally led him to McGraw-Edison. Upon contracting a Mr. William Doherty with McGraw-Edison, Mr. Sikes was told that McGraw-Edison was very hungry for a Weed-Eater-like product at that time (TR 89). Mr. Sikes was also told that McGraw-Edison was at a critical time in the marketplace and that each day counted if they were to have a shot at having a product available for exhibition at the new product home show in August (TR 91). Mr. Sikes made immediate plans to visit the company's plant at Columbia, Missouri, and did in fact go to the plant, on January 23, 1976, with a working model of his tool and various plans and specifications (TR 91-92, 104).

Upon arriving at McGraw-Edison's plant, Mr. Sikes was told that the interest in his tool was so great because McGraw-Edison was at that time considering three different grass trimming devices: (1) a German model—concerning which negotiations were terminated, or virtually terminated; (2) the Huey model—a model submitted by a Mr. Huey from College Station, Texas, which design McGraw-Edison did not think had much potential;

and (3) a developmental model—with which McGraw-Edison itself was experimenting, but which was some two years away from production (TR 102-103).

Charles Sikes disclosed his ideas to McGraw-Edison at that January meeting by exhibiting a working model of his tool, by providing written materials and engineering drawings explaining the concept of his tool, and by giving an oral presentation explaining all aspects of the workings of the tool, the interrelationships involved therein, and the factors which he believed caused his tool to be very desirable and very useful to consumers (TR 104). No one indicated at that time that they were already working on a product similar to the Sikes tool (TR 107). From all indications Charles Sikes was able to observe, his presentation was the first time any of the McGraw-Edison executives he met ever considered a product such as his (TR 107-108).

Less than 17 days later, however, on February 10, 1976, after having been excited and enthusiastic about Respondents' disclosures, and after having questioned Charles Sikes about the price he wanted for the right to use his ideas and having told him that $0.50 per unit royalty was about right, Charles and Arnold Sikes were told by McGraw-Edison that it had developed its own product which was very similar to the Plaintiffs' grass cutting tool. McGraw-Edison still wanted to buy the Plaintiffs' ideas, however, claiming that its model would cost a few cents more per unit to manufacture. McGraw-Edison wanted the Sikes brothers to accept the "alleged" few cents per unit difference in manufacturing costs as royalty for the use of their ideas. The Sikes brothers refused (TR 111, 129).

McGraw-Edison did indeed come out with a Weed-Eater-type product in time for the August, 1976 product home show (TR 80). That tool, the Graswhip, was remarkably similar to the product Charles Sikes had re-

vealed to McGraw-Edison just six months earlier, according to the testimony of the expert witnesses (TR 231).

Both the Graswhip and the Sikes model employed a small lightweight universal type electric motor (TR 231). The Sikes model had been built around the lightweight Black & Decker 8200 motor, but Sikes had told McGraw-Edison in his disclosures that the 8200 motor was not of sufficient size and did not supply sufficient torque for optimum cutting (TR 148). The motor of the Graswhip was also small and lightweight. But, just as Charles Sikes had suggested, the motor of the Graswhip was slightly larger than the 8200 motor. Whereas the 8200 delivered 11,800 rpm at maximum load, the Graswhip delivered 16,650 rpm at maximum load. And whereas the 8200 had a torque of approximately .9 amps, the torque of the Graswhip was 1.3 amps (TR 232-234). So, the Graswhip captured the Sikes idea of using a motor slightly more powerful than the Black & Decker 8200, but keeping the motor small and lightweight. The whole idea behind the Sikes concept had been that a small motor, employing certain other prescribed factors, could cut effectively, yet be lightweight enough to be operated with one hand, and small enough to get in tight places (TR 72-73, 75). The size of the motor was vital to this concept because 90% of the tool's overall weight was motor (TR 142). The Graswhip followed this Sikes idea precisely.

Also important to the Sikes tool was the size of the cutting line, both in length and in thickness. The line had to be such as would complement the small motor (TR 64). Prior to Sikes, most people had, when going to a lightweight motor, gone to a lighter line. Sikes went the other way (TR 149). His disclosures taught the use of a large (thick) line with the small motor so that upon contact with a solid object the motor would load down, producing an audio feedback, and allow the operator an opportunity to pull the line away from the object without breaking

the line (TR 149). The Sikes disclosures also taught the use of a much shorter line than others had used. This shorter line was significant for a number of reasons, including the fact that such produced a smaller cutting radius so as to fit the Sikes concept of a small lightweight tool which could fit in tight places (TR 72, 75). The length of the line was also significant because it was the interrelationship between the size of the motor and the thickness and length of the line which resulted in developing the desired tip velocity and handling characteristics (TR 139). There was also expert testimony that the length of the line was significant because a longer line would tend to load down the small motor and would not last as long as the shorter line (TR 241, 244).

Once again, as to the length and thickness of cutting line used, the Graswhip was almost identical to the Sikes tool. As far as relevant length of line is concerned, that being the distance from the center of the rotation to the tip of the cutting line, the Graswhip used a 2.9 inch line, whereas the Sikes tool used a 2.8 inch line (TR 236). An insignificant difference between the two when viewed in light of the fact that other tools were using lines of six to nine inches (TR 167, 241). Further, the thickness of the line used by the Graswhip was .063 inches in diameter, identical to the thickness of line used by the Sikes tool (TR 235).

The Weed Eater, which was the only successful monofilament line grass trimmer on the market at the time of Charles Sikes' development of his tool, contained a spool of line, which spool was rotated by the motor. As the line broke, more line was unrolled from the spool. This often required great effort (TR 124). The Sikes tool involved a different process. No spool was used. Instead, a hole was to be drilled through a plastic holder affixed to the shaft and a single piece of line was inserted through the hole. One end of the line was enlarged so that the line would not slide completely through the hole. The line

was to be held in place by centrifugal force. This concept allowed broken line to be quickly and easily replaced. When one line broke another line could just be slipped right through the holder (TR 82). There were never any spools to replace, nor was a large motor required because of added stress of having to turn the entire spool. Such made the Sikes took a very desirable product from the consumer's point of view (TR 82).

The philosophy of the Graswhip was the same in this regard as the Sikes tool. The Graswhip employed the same idea of eliminating the spool of line and going to a short, single strand of line (TR 82, 74). The Graswhip employed the same idea of a plastic holder on the end of the motor's shaft (TR 82). And while the method of affixing the line to this holder was not the same in the Graswhip as it was in the Sikes tool, the philosophy was the same, the variation being only in the means used to reach the objective taught by the Sikes tool. Furthermore, this was done not as an improvement to the operation of the tool itself, but as a means of requiring a cutting line which would have to be purchased from McGraw-Edison (TR 108-109).

The Sikes tool also taught that by beveling the hole where the cutting line exited the plastic holder, the stress placed upon the line would be spread over a larger surface area. This would cause each piece of line to last much longer (TR 77). The Graswhip employed this same concept (TR 237).

Mr. Edward Irelan, the manager of design engineering and industrial design for McGraw-Edison, when questioned concerning design drawing of the Graswhip, testified that the earliest drawing or sketch prepared by McGraw-Edison was done around April 23, 1976 (TR 564). This was over two months after the meeting of February 10, 1976, at which McGraw-Edison claimed to have already developed a product which was very similar

to the Sikes tool. Mr. Irelan had previously testified that in developing a tool such as the Graswhip you first agree on a concept and you then prepare visual design sketches of that concept to establish the direction that you hope to go (TR 199). The visual design sketches, according to Mr. Irelan, pre-date the engineering drawings from which the product is to be tooled, much less the assembly of any parts (TR 199). The fact that the first sketch of the Graswhip was not prepared until April 23, 1976, was evidence, therefore, not only that McGraw-Edison had lied to the Sikes brothers at the meeting on February 10, 1976, but also that McGraw-Edison developed the Graswhip after being taught the Sikes concept and by employing the ideas it had learned from Sikes.

Walter Sullivan, who was employed by McGraw-Edison at the times relevant to this lawsuit in the capacity of Vice-President of marketing for the tool division of McGraw-Edison's Portable Appliance and Tool Group, testified as follows:

> I would say that this tool [the Sikes tool] was the start of McGraw-Edison's development of their Graswhip, that this was the tool that we used out in the field for testing, and we took our motors and envelopes and tried to develop the tool [the Graswhip] from this product, from this one here [the Sikes tool]. (TR 373).
>
> We took that idea [the Sikes tool], proceeded immediately to develop working models and introduce that tool at the hardware show in Chicago in probably August or September of that year (TR 376).

Dwight Beach, who was the director of engineering of McGraw-Edison's Power Tool Division during this time, testifying by deposition, also testified that McGraw-Edison utilized the Sikes' design and ideas. And while he testified that McGraw-Edison changed some aspects of the Sikes' design in making the Graswhip, he testified

that it was the Sikes' design which got McGraw-Edison "off the dime," and gave Petitioner its big push in the direction it went with the Graswhip (TR 339).

Edward Irelan, the manager of design engineering and industrial design for McGraw-Edison, who testified that the Graswhip was designed and put on the market under his supervision and direction (TR 198), testified as follows:

> There had been serious negotiations with Mr. Sikes and we were instructed to use that [the idea of a single flail contained in the Sikes' disclosure] (TR 202).

Mr. Ireland further testified that he had been directed by Dwight Beach, who had been director of engineering for McGraw-Edison, that since talks were proceeding with Charles Sikes, he was "to proceed on the design [McGraw-Edison's design] and to use that method [the Sikes method].

Such represents a statement of the facts relating to Petitioner's utilization of Respondents' ideas. Petitioner, in addition to denying utilization of Respondents' disclosures, attempted to defend this suit upon the basis that the information disclosed was already in its possession, of public knowledge, and/or was in the public domain as of January 23, 1976, the date of the parties' disclosure agreement. Such defenses were based upon the disclosure agreement existing between the parties, which agreement provided that confidentiality as to Mr. Sikes' disclosures would be maintained by McGraw-Edison "unless such submitted information can be shown by McGraw-Edison to have been in its possession, or of public knowledge, or to have been in the public domain prior to such submission . . . ."

Petitioner contended before the Fifth Circuit that the judgment against it was erroneous because it had established that Respondents' disclosures were such as to

which no duty of confidentiality existed. *Sikes v. McGraw-Edison Company*, 665 F.2d 731 (5 Cir. 1982). The Fifth Circuit expressly addressed that contention, holding:

> It is clear that much of the information transmitted to McGraw-Edison by Mr. Sikes was of a public nature . . . . And McGraw-Edison itself had received disclosure earlier from a Mr. Shubert of a modification of the same commercial trimmer . . . .
>
> We think that . . . the jury . . . could properly have concluded that the Sikes device, actual and functioning, went significantly beyond any "information" in McGraw-Edison's possession, of public knowledge, or in the public domain at the time of its submission. (665 F.2d, at 735-736)

There can be little doubt from the facts, when viewed in the light most favorable to the jury's verdict, there is sufficient evidence that Petitioner breached its agreement of confidentiality and misappropriated Respondents' intellectual property. Such facts are important in order that the Court have an understanding of the background which spawned the inquiry before this Court, but do not directly concern that inquiry. The inquiry before this Court is limited to deciding whether Texas law, as followed by the trial court and the Fifth Circuit, in affording protection to Respondents for their intellectual property, has created a barrier to federal patent policies and has protruded into that portion of the field of trade regulation as is pre-empted by federal patent laws.

SUMMARY OF THE ARGUMENT

This case was tried and decided solely upon principles of Texas law. Petitioner raises for the first time, before this Court, questions as to validity of Texas law, and asserts that Texas law constitutes a barrier to federal patent policies: (1) because the contractual rights created by the parties' disclosure agreement were abrogated; and (2) because Texas law treats as trade secrets information disclosed in the normal process of exploitation.

First, neither Texas law, nor the trial court, abrogated contractual rights of the parties. The rights to which Petitioner makes reference are those contained within the parties' disclosure agreement, which agreement excluded from the duty of confidentiality information already in its possession, of public knowledge or in the public domain. The trial court charged that if the jury found the Respondents' disclosures to have already been in Petitioner's possession, of public knowledge or in the public domain, it should find for Petitioner. The jury found for Respondents. The Fifth Circuit found the evidence sufficient to support the jury verdict in this regard. Hence, it is clear that this case does not involve an abrogation of contractual rights, but involves the refusal of a litigant to accept fact finding made against it. There is no legitimate federal question involved meriting the consideration of this Court.

Secondly, while it is true that Texas does protect information disclosed in the normal process of exploitation, and provides that protection under the commonly utilized Restatement definition of trade secret, such creates no barrier to federal patent policies. This Court has held that such information possesses proprietary value and that protection of such information is even less offensive to federal patent policies than is the protection afforded to trade secrets not disclosed by exploitation, since the latter remains hidden from the public. Texas law protecting information disclosed in the normal process of exploitation, therefore, under the theory of trade secrets, and exacting an equivalent level of proof as to novelty and secrecy as are required for trade secrets not disclosed in the normal process of exploitation, cannot be deemed an impermissible barrier to federal patent policies where it has been held by this Court that, until Congress takes affirmative action to the contrary, states should be free to grant protection to trade secrets.

ARGUMENT OF REASONS FOR DENYING WRIT

1. The decision of the Fifth Circuit, upholding Texas law, does not abrogate contractual rights so as to conflict with a holding of this Court or with federal patent policies, but instead follows and furthers such.

Petitioner, McGraw-Edison, in stating its reasons for asserting that its writ should be granted, does not suggest that, in rendering its judgment in the case *sub judice*, the Court of Appeals for the Fifth Circuit rendered a decision in conflict with the decision of another federal court of appeals on the same matter, has decided a federal question in a way to conflict with a state court of last resort, or has departed from the accepted and usual course of judicial proceedings. Petitioner states only that the Fifth Circuit's refusal to uphold the contractual provisions between the parties runs counter to a principle enunciated by this Court in *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257 (1979).

Petitioner apparently seeks to come within Rule 17.1(c). Respondents would contend, however, that the question presented by Petitioner does not come within Rule 17, Supreme Court Rules, there being no direct conflict between the Fifth Circuit's decision and any decision of this Court or of any decision of a federal court of appeals, and no important federal question which should be settled by this Court. This Court's decisions in *Kewanee Oil Co. v. Bicon Corp.*, 416 U.S. 470 (1974) and *Aronson v. Quick Point Pencil Co., supra*, are dispositive of all federal questions which might have been raised.[1]

Furthermore, asserting that the Fifth Circuit decision in this case runs counter to a principle enunciated by

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[1] Petitioner raised no questions of federal law before the federal district court or the federal court of appeals. This case was removed from state court solely on the basis of diversity and tried solely under principles of Texas law. *Sikes v. McGraw-Edison Co.*, 655 F.2d 731, 732, 733-734 (5 Cir. 1982); *Sikes v. McGraw-Edison Co.*, 671 F.2d 150, 151 (5 Cir. 1982).

this Court, i.e., that inventors should be able to enter into binding contracts regarding their inventions, Petitioner would have this Court accept as uncontradicted its bald conclusion that its contractual obligations were abrogated. Petitioner's conclusion that its contracted rights were abrogated represents the foundation upon which Petitioner's entire legal theory is built; if that foundation is not sound, if Petitioner's contractual rights were not abrogated, the conflict Petitioner envisions as existing, and to which the bulk of its petition is dedicated to explaining, is illusory. Respondents, on the other hand, are not limited to, and do not ask this Court to accept, bald conclusions. The record in this case clearly establishes that, in truth and in fact, Petitioner's contractual rights were fully recognized and protected throughout this litigation. Petitioner's refusal to recognize such (Petitioner's Br., p. 6, fn.*) is no more than a refusal to accept those findings of the jury prejudicial to theories upon which Petitioner sought to defend its actions.

It is true that the trial court instructed the jury in this case as to the law of trade secrets. The jury was instructed that unless Petitioner, as plaintiff, established, by a preponderance of the evidence, that its rotary lawn trimmer constituted a trade secret, and that McGraw-Edison incorporated and utilized that trade secret, a verdict should be returned for McGraw-Edison (TR 653). The trial court did not, however, as Petitioner would have this Court believe, abrogate the terms of the parties' contract by instructing only as to trade secret. The trial court placed upon Respondents the double-barrel burden of proving not only that their disclosures constituted a trade secret, but also of securing a finding that their disclosures were not excluded from petitioner's duty of confidentiality by contract.

The jury was charged, in addition to trade secret, that if they found the information furnished by the Sikes brothers was in the possession of McGraw-Edison,

or of public knowledge, or was in the public domain as of January 23, 1976 (the date of the parties' contract), then they were to find for the Defendant, McGraw-Edison (TR 660; cf Pl.Ex.No. 1, TR 36). Such are the "protective provisions under which the recipient [Petitioner] agreed to consider the submitted new product idea" (Petitioner's Br., p. 8). It is readily apparent from the trial court's charge that the parties' contract, and specifically its "protective provisions," was not abrogated. The jury merely found against Petitioner in its efforts to bring itself with the coverage of its "protective provisions," finding that the information furnished by Respondents was not in Petitioner's possession, was not of public knowledge, and was not in the public domain.

The Fifth Circuit, in *Sikes v. McGraw-Edison*, 665 F.2d 731, 735 (5 Cir. 1982), expressly addressed Petitioner's contention that, under the terms of the parties' express contract, it had no obligation with respect to information that was "in its possession, or of public knowledge or to have been in the public domain prior to such submission." The Fifth Circuit held:

> The [trial] court charged the jury in exact conformity with this language, directing it to find for McGraw-Edison if any of the above circumstances was established by a preponderance of the evidence. Since it [the jury] did not, the question becomes whether its verdict is clearly erroneous on the basis of the evidence.
>
> * * *
>
> The jury could properly have found, as it did, that McGraw-Edison breached its agreement with Mr. Sikes. (665 F.2d, at 735, 736)

In light of the above, it is unclear how Petitioner can realistically contend that its contractual rights were abrogated. There is certainly no support for its unqualified assertion to this Court that all three conditions existed, i.e., that the information was in its possession, of public

knowledge and in the public domain prior to submission (Petitioner's Br., p. 6, fn*).

The true nature of the petition for writ of certiorari, therefore, is not one based upon a refusal of the Fifth Circuit, or of the trial court, to uphold contractual provisions between the parties (Petitioner's Br., p. 6). The true nature of the petition is an argument with a Texas jury as to its findings on disputed questions of fact, and an argument with both the trial court and the Fifth Circuit as to the legal sufficiency of the evidence. Sufficiency of the evidence points are not such as are generally found to be within the purview of U.S. Sup. Ct. Rule 17.1, 28 U.S.C.A., governing considerations for review on petition for writ of certiorari.

2. Texas law's inclusion of intellectual property disclosed in the normal process of exploitation, within the commonly accepted definition of trade secrets, presents no barrier to federal patent law and represents legitimate state regulation of the use of intellectual property.

Petitioner argued and tried this case upon the premise that the intellectual property disclosed by Respondents constituted the submission of a new product idea, and not the submission of trade secrets, since public disclosure would occur in the normal process of exploitation. The Fifth Circuit initially addressed this contention in its original opinion (665 F.2d, at 733-734); and subsequently rendered a very capable opinion in response to Petitioner's petition for rehearing, addressing this contention exclusively (671 F.2d, at 151). Such was found to be without merit under Texas law. The question before this Court, therefore, must be limited to a determination of whether Texas' protection of intellectual property disclosed in the process of exploitation, under the commonly accepted definition and evidentiary requirements of trade secrets, constitutes a barrier offensive to federal patent policies. The fact that other jurisdictions may have chosen to exclude "new product ideas" from

the definition of trade secrets, and regulate the use of such intellectual property through the imposition of different evidentiary requirements, matters not; if Texas' regulations are not inconsistent with federal patent policies, such represent legitimate state regulation in an area where federal pre-emption is limited to that state regulation which "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress." *Aronson v. Quick Point Pencils Co., supra,* at 262.

In *Aronson,* this Court had before it a case involving the design for a keyholder which, although characterized by the Court as ingenious, was so simple that it could be readily copied unless it was protected by patent. While the patent application was pending, the inventor, Mrs. Aronson, negotiated a contract with the Quick Point Pencil Co. for the manufacture and sale of the keyholder. That patent application was ultimately rejected on the ground that the keyholder was not patentable.

The decision in *Aronson,* while not addressing the exact question presented here, recognized the value of unpatentable inventions and recognized that a proprietary interest exists in such inventions which might be licensed by the inventor. This Court not only found the existence of a proprietary interest in such inventions to *not* be inconsistent with the aims of the federal patent system, but held that recognition of a claimed proprietary interest in such a device, although it be unpatentable and ceases to have any secrecy as soon as it is first marketed, yet prior thereto possessed inventiveness and novelty sufficiently apparent to induce an experienced manufacturer to agree to pay for the opportunity to be first in the market, is even less offensive to federal patent policies than state law protecting trade secrets which are not disclosed in the normal process of exploitation (440 U.S., at 266). It was even held that the recognition of a proprietary interest in such non-patentable property

actually furthered federal policy by providing additional incentive to invention and encouraging manufacture which itself disclosed the novel idea embodied wherever the product was sold (440 U.S., at 262-263).

Hence, while this Court did state in *Aronson* that state trade secret law does not ordinarily cover confidential information disclosed in the normal process of exploitation, it made clear the fact that such information constitutes proprietary intellectual information subject to being protected without offending federal patent policies. Surely, if protection of such information is "less offensive to federal patent policies than state law protecting trade secrets," the protection afforded one possessing a proprietary interest in such property, under Texas law treating such information as a trade secret, and exacting an equivalent volume of proof as to novelty and inventiveness, cannot be deemed to infringe federal patent policies.

The treatment of "new product ideas" as trade secrets creates no obstacle to the accomplishment and execution of the full purposes and objectives of Congress in instituting existing patent policies. In fact, Texas law had the exact effect this Court found to be compatible with federal objectives in *Aronson*. Respondents were encouraged to make arrangements for the manufacture of their grass trimmer, furthering the federal objective of promoting disclosure of inventions. *Aronson v. Quick Point Pencil Co.*, *supra*, at 262-263. By affording a remedy for the misappropriation of a "new product idea," albeit under the definition of trade secret, Texas law provided additional incentive for invention. *Aronson v. Quick Point Pencil Co.*, *supra*, at 262. And while the inventiveness and novelty of Respondents' disclosures are not evidenced by the agreement of an experienced manufacturer to pay for the opportunity to be first in the market (*Aronson v. Quick Point Pencil Co.*, *supra*, at 266); the inventiveness and novelty of Respondents' dis-

closures are evidenced by the utilization of such disclosures by an experienced manufacturer for the opportunity to be first in the market, as found by the jury, and by a wealth of testimony as to the importance of Respondents' disclosures (TR 376, 339, 202).

Texas law, as perceptively analyzed by Judge Gee in the opinions of the Fifth Circuit, protects, under the label of trade secret, the proprietary interest of an inventor as to a non-patentable invention even though such trade secret be disclosed in the normal process of exploitation. This Court has repeatedly held that states are free to regulate the use of intellectual property in any manner not inconsistent with federal law. *Aronson v. Quick Point Pencil Co.*, *supra*, at 262; *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 479 (1974). It was held in *Aronson* that the recognition of a proprietary interest in confidential information which ceases to have any secrecy once marketed, is even less offensive to federal patent policies than state law protecting trade secrets. It was held in *Kewanee* that patent law does not pre-empt trade secret law and that such have co-existed in this country for over one hundred years. In *Kewanee*, a diversity case, Ohio's definition of trade secret, which is identical to that followed by Texas and used by the trial court in this case in charging the jury, was upheld. There is simply no justification for federal pre-emption of state law protecting an inventor's property rights in intellectual information, although disclosed in the normal process of exploitation, where identical requirements for novelty and inventiveness are imposed as are required for traditional trade secrets.

CONCLUSION

WHEREFORE, premises considered, Respondents respectfully pray that this Court deny Petitioner's writ of certiorari, there being no basis for federal intervention into this suit, tried exclusively under principles of Texas

law. Furthermore, there is simply no basis for Petitioner's position that its contractual rights were abrogated by either the trial court or the Fifth Circuit, Petitioner's argument instead being with a verdict duly rendered by a jury, which verdict finds support in the evidence. Lastly, there is no merit to Petitioner's claim, raised for the first time before this Court, that the remedy afforded Respondents under Texas law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress and federal patent policies.

Respectfully submitted,

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No. 81-2053

In the
Supreme Court of the United States
OCTOBER TERM, 1981

McGRAW-EDISON COMPANY,
Petitioner,

vs.

CHARLES L. SIKES, ET AL.,
Respondents.

REPLY BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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REPLY

Respondents, in their repeated assertions [Br.* 10, 12 (fn. 1), 19] that the conflict between Texas trade secret law and federal patent policies, as well as related decisions of this Court, was not raised below, overlook the fact that it was not until the Opinion of the Fifth Circuit denying the Petition for Rehearing (P. 16a-19a) that the issue was squarely presented. Then, for the first time, Petitioner was faced with an express holding that Texas trade secret law "has so far followed a course somewhat different from that of other states." (P. 18a)

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* Br. is used to designate page(s) of Respondents' Brief and P. is used to designate page(s) of the Petition for a Writ of Certiorari.

The "difference" perceived by the Fifth Circuit is that Texas trade secret law, not an express contract between the parties, governs their respective rights and obligations regarding a submitted idea. It is this "difference" that brings Texas trade secret law into conflict with federal patent policies and prior holdings of this Court.

Respondents further attempt to create the erroneous impression that Petitioner is only contesting the factual determinations of the jury. Petitioner's contention is that by utilizing Texas trade secret law to establish a right of recovery for Respondents, both the trial court and the Fifth Circuit deprived Petitioner of its contractual rights and of a hearing on the initial and ultimate factual issue — whether Petitioner breached its agreement with Respondents.

If the rights of the parties were defined and controlled by the contract between them, Respondents had no right of recovery absent a breach of that contract. Essential to a claim for breach of their contract was a showing by Respondents that the submitted idea met the criteria of the contract (P. 2) under which Petitioner agreed to be bound. In holding that the right of recovery existed under Texas trade secret law, rather than under the terms of the contract, the Fifth Circuit has brought Texas trade secret law squarely into conflict with federal patent policies and the holdings of this Court.

As stated in *Aronson* v. *Quick Point Pencil Co.*, 440 U.S. 257, 264 (1979): "We have held that a state may not forbid the copying of an idea in the public domain which does not meet the requirements for federal patent protection. *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Sears, Roebuck & Co.* v. *Stiffel Co.*, [376 U.S. 225 (1964)]." By its inclusion of ideas that

are disclosed upon exploitation, Texas trade secret law, when employed as a basis for recovery for the use of ideas so disclosed, runs afoul of this principle of patent policy supported by the decisions of this Court, by recapturing that which has passed into the public domain. As pointed out in *Lueddecke* v. *Chevrolet Motor Co.*, 70 F.2d 345, 349 (8th Cir. 1934):

> . . . In Bristol v. Equitable Life Assur. Soc., supra, the court stated: "Without denying that there may be property in an idea or trade secret or system, it is obvious that its originator or proprietor must himself protect it from escape or disclosure. If it cannot be sold or negotiated or used without a disclosure, it would seem proper that some contract should guard or regulate the disclosure; otherwise, it must follow the law of ideas, and become the acquisition of whoever receives it."

Unless a breach of a contract has been established, there is no right of recovery, and the use of Texas trade secret law to grant recovery in the absence of such a breach withdraws the idea from the public domain in contravention of federal policy.

Not only does the use of Texas trade secret law as the basis for recovery of an idea disclosed upon exploitation, to the exclusion of a contract under which the disclosure was made and accepted, conflict with federal patent policy, it deprives the contracting recipient of his Constitutional right to due process of law. "An idea once communicated can no longer be exclusively appropriated and enjoyed." Robinson on Patents, §24 (1890)*. The

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* See Choate, *Patent Law*, p. 2 (West Publishing Co. 1973).

use of Texas trade secret law to by-pass the only vehicle by which the communicated idea can be prevented from passing into the public domain — the contract between the discloser and the recipient — prevents the recipient from having his rights considered in accordance with the due process of law. Hence, such a state law not only violates the recipient's Constitutional right to have his contractual rights and obligations decided in accordance with the due process of law, but also is in conflict with federal patent policy and the holdings of this Court.

Respondents concur in the Fifth Circuit view that Texas law grants trade secret status to ideas that are disclosed in the process of exploitation. (Br. 11, 15-18) The purported justification for this approach is that the states have the right to define their trade secret laws, and that since this Court found that trade secret law is not federally pre-empted in *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U.S. 470 (1974), then the Texas definition of its trade secret law to cover ideas disclosed during exploitation is unobjectionable. Application of the overworked term "bootstrapping" to this argument cannot be avoided.

The holding of *Kewanee* does not give free rein to a state to give protection to anything that it decides to classify as a "trade secret". State trade secret law cannot be interpreted in a way to interfere with federal patent policy as propounded by this Court, the situation found in the present case.

Respondents discuss trade secrets and ideas that would be disclosed in the process of exploitation in the context of a time prior to disclosure. But that is not the time

frame or the question involved here. This case involves the question of rights at the time that the idea is disclosed, pursuant to a contract, for purposes of realizing a monetary return. It is by ignoring this time factor, with the change in status resulting from communication of the idea, that Texas trade secret law is clearly in derogation of federal patent policy and due process of law.

The Petition for a Writ of Certiorari pointed out (P. 12-14) that the Court of Appeals decision in this case is in conflict with decisions of other courts. Other courts have held that in submission of a new product idea, there must be novelty in the idea. The Brief in Opposition recognizes the conflict, but urges that the reason is that Texas law was applied in this case. This may explain the divergence, but it does not justify ignoring it. The conflict points out that other circuits have recognized the change in status once exploitation has commenced of an idea that is disclosed by such exploitation, by requiring that novelty must be shown before relief can be justified. Thus, they have upheld federal patent policy, unlike the Fifth Circuit in this case.

It is clear that the unresolved issue raised in *Lear* v. *Adkins,* 395 U.S. 653, 675 (1969) (P. 8), in the aspect of trade secret law superseding a contract setting forth the terms for submission of an idea that is disclosed upon exploitation, is ripe for determination by this Court. Even the Fifth Circuit, in denying the Petition for Rehearing, although not recognizing the conflict with fed-

eral patent policy and the violation of due process, did question the wisdom of Texas law: "We do not say that the distinctions pressed upon us by petitioner are untenable or even that they may not present the more logical view." (P. 19a) The Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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